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No. 03-1042

Supreme Court, U.S.
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In The

Supreme Court of the United States

SENIOR TECHNOLOGIES, INC.,

Petitioner,

v.

R.F. TECHNOLOGIES, INC.,

Respondent.

On Petition For Writ Of Certiorari To The United States Court Of Appeals For The Federal Circuit

BRIEF IN OPPOSITION

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QUESTIONS PRESENTED FOR REVIEW

1. Was it error for the CAFC to adhere to its original construction of Claim 1 following a remand from the U.S. Supreme Court on the issue of the Doctrine of Equivalents?

2. Was it error for the CAFC to decide the issue of infringement under the Doctrine of Equivalents based on the claim language?

CORPORATE DISCLOSURE STATEMENT

R.F. Technologies, Inc. has no parent corporation and has issued no shares to the public.

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STATEMENT OF THE CASE

This case involves the construction of Claim 1 of U.S. Patent No. 4,682,155 (the "'155 Patent") owned by Petitioner, Senior Technologies, Inc. The '155 Patent covers a wanderer monitoring device that has a transmitter affixed to the limb of the monitored individual, a sensing module mounted adjacent to a monitored doorway, a door switch mounted on a monitored door, and an alarm. (A-96-97).

Claim 1 recites the components of the security sensing system to include a sensing module for installing adjacent to a monitored door. (A-96). The sensing module responds to the signals from the transmitter and produces an output response which in turn energizes an alarm, when the monitored door is open. (A-97). The sensing module is defined as "including a receiving circuit and associated sensing means," all of which are adjacent to the monitored door. (A-97). Claim 1 specifies that the receiving circuit is inside the sensing module. (A-97).

Respondent, R.F. Technologies, Inc., manufactures personal monitoring systems. Petitioner originally accused eighteen (18) of Respondent's systems of infringing all eighteen (18) claims of the '155 Patent, as well as claims in another patent owned by Petitioner which was not the subject of appeal to the CAFC, the first Petition for Certiorari, or this Petition for Certiorari. (A-39, footnote 3). At the close of Plaintiff's case, the district court dismissed the infringement claims against fourteen (14) of Respondent's eighteen (18) accused systems due to Petitioner's failure to offer sufficient evidence concerning the operation of these accused devices and how these devices allegedly infringed the patents at issue. (A-39, footnote 3). At the conclusion of the trial, the court found the four remaining

accused devices did not infringe any of the claims of the '155 Patent or the other patent owned by Petitioner. (A-61, ¶ 18; A-65-66, ¶ 28).

The district court found that Claim 1 disclosed a "sensing module" with a receiving circuit inside that responded to the signals from the transmitter and produced a response. (A-58, ¶ 12). Claim 1 required the sensing module to be mounted adjacent to the monitored door. *Id.* The district court also found that the sensing module mounted adjacent to the door included the "sensing means" or antenna. (A-42, ¶ 9; A-58, ¶ 12). The district court found that the accused products did not have **both** the claimed receiving circuit and associated sensing means in the sensing module located adjacent to the door and therefore they did not infringe Claim 1. (A-61, ¶ 18). This difference was one of three bases on which the district court found the four accused devices did not infringe Claim 1. (A-61, ¶ 18). The district court also concluded that the accused devices did not have the "receiving circuit" disclosed in Claim 1 and the accused devices were always enabled, whereas the receiving circuit in the '155 Patent was disabled until the door switch ("means to enable") enabled the receiving circuit. (A-61, ¶¶ 18, 20; A-65, ¶ 28).

Petitioner appealed, but **did not** appeal the district court's construction of the sensing module in Claim 1 and specifically did not appeal the district court's conclusion that the receiving circuit **and** sensing means or antenna are in a single sensing module, which must be located adjacent to the monitored door. (R. App. 2-5). Instead, Petitioner appealed the construction of Claim 6. (R. App. 4).

Petitioner's only argument on appeal to the CAFC relating to the sensing module in Claim 1 was challenging

the district court's factual conclusion that the receiving circuit **and** sensing module in the accused devices **are** located adjacent to the monitored door. Petitioner argued that an infringing device **could** be, but was not required to be, located adjacent to the door, and that it was error for the district court to find to the contrary. (R. App. 26-27).

Petitioner's principal focus on appeal was the district court's conclusion that the accused products did not have the disclosed receiving circuit and that the disclosed receiving circuit was disabled until the door switch ("means to enable") enabled the receiving circuit, unlike the accused devices, which were always enabled. (R. App. 2-4).

The CAFC agreed the receiving circuit in Claim 6 was disabled until enabled, disagreed that the receiving circuit in Claim 1 was disabled until enabled and concluded the district court erred in its comparison of the accused products' receiving circuit to the disclosed receiving circuit. (A-22-25, 30).

Petitioner incorrectly states that the CAFC found the district court's finding of non-infringement was clear error. The CAFC held the district court's conclusions that the accused products did not have the disclosed receiving circuit was clear error. (A-22). The CAFC **affirmed** the district court's finding of non-infringement based on its construction of the sensing module, which was consistent with the district court's construction. (A-23-25, 28).

Key to the CAFC's infringement analysis was the composition and location of the "sensing module," the device that receives signals from a transmitter, and produces an output response to energize an alarm. The CAFC concluded that the patent required the "sensing means" or antenna (the device that receives the signal

from the transmitter) and the receiving circuit (the device that produces an output response to energize an alarm) be part of the sensing module, which must be located adjacent to a monitored door. (A-23-25, 28).

The CAFC also analyzed the accused devices under the Doctrine of Equivalents. As to three devices, the CAFC concluded there was no infringement under the Doctrine of Equivalents because the definition of sensing module in Claim 1 was amended to overcome a rejection based on indefiniteness and the amendment specifically recited that the receiving circuit was in the sensing module. (A-29, 29). Petitioner never offered any alternative explanation for this amendment and the CAFC concluded prosecution history estoppel applied. (A-14, p. 14.) The Court concluded these accused devices did not have an element equivalent to the claimed sensing module because only part of the receiving circuit was in the sensing module adjacent to the door. *Id.*

As to the fourth device, the CAFC concluded Claim 1 did not disclose a device with an antenna located in a separate unit. Applying the "all limitations" rule, the Court concluded the claim could not be expanded under the Doctrine of Equivalents. (A-29). *See Athletic Alternatives, Inc. v. Prince Manufacturing, Inc.*, 73 F.3d 1573 (Fed. Cir. 1996). Therefore, the accused device which has an antenna in one unit and a receiving circuit in another unit did not infringe Claim 1 under the Doctrine of Equivalents. (A-28-29) .

Petitioner sought rehearing on the CAFC's construction of the sensing module in Claim 1, even though Petitioner had **never** challenged the district court's construction of the sensing module in its original appeal to

the CAFC. (R. App. 40-41; R. App. 2-5; 26-27.) The Petition for Rehearing was denied.

Petitioner then filed a Petition for Certiorari with this Court seeking review of Claim 1 and review of the CAFC's analysis under the Doctrine of Equivalents. (R. App. 57). This Court granted the Petition and, following this Court's decision in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 535 U.S. 722, 122 S.Ct. 1831, 152 L.Ed.2d 944 (2002) (*Festo VIII*), vacated and remanded this case and eight others to the CAFC for further consideration. *See Lockheed Martin Corp. v. Space Systems/Loral, Inc.*, 324 F.3d 1308, 1310 (Fed. Cir. 2003) (describing disposition of related cases following this Court's decision in *Festo VIII*).

Petitioner now challenges the CAFC's decision following remand and asks this Court to accept review of that decision in order to adopt Petitioner's construction of Claim 1, find literal infringement and reverse several decades of past decisions concerning the Doctrine of Equivalents.

SUMMARY OF ARGUMENT

Petitioner argues that certiorari should be granted because the CAFC improperly imported an additional limitation into Claim 1, improperly added a new limitation to the Doctrine of Equivalents, and impermissibly "sidestepped" this Court's decision in *Festo VIII*. Petitioner further argues this case should be reversed and an entire line of other CAFC decisions should be overruled so the Doctrine of Equivalents is governed by Petitioner's conception of the Court's decision in *Graver Tank & Mfg. Co. v.*

Linde Air Products Co., 339 U.S. 605, 705 S.Ct. 854, 94 L.Ed. 1097 (1950).

As will be demonstrated below, Petitioner's arguments regarding the construction of Claim 1 are moot, as they were never raised by Petitioner in its appeal from the District Court. In addition, nothing in the mandate of this Court directed the CAFC to review its construction of Claim 1. Nonetheless, the CAFC's construction is supported by the language of Claim 1, the specification and the prosecution history. Further, the CAFC applied well-established precedent in reaching its decision that there was no infringement under the Doctrine of Equivalents. Finally, none of the arguments advanced by Petitioner warrant reversal of decades of decisions developing the Doctrine of Equivalents.

REASONS FOR DENYING PETITION

Petitioner's original appeal to the CAFC never challenged the District Court's construction of Claim 1, which the CAFC adopted in its original decision. Accordingly, Petitioner waived any challenge to that construction.

This Court did not reach the issue of the CAFC's construction of Claim 1, and provided no directions to the CAFC on that issue.[1] Accordingly, the CAFC was free to adhere to its original construction of Claim 1.

[1] Indeed, this Court did not reach any of the issues raised in Petitioner's first Petition. Rather, this case was one of many held in

(Continued on following page)

The CAFC properly construed Claim 1 by its review of the claim language in light of the specification and drawings. Based on that language, there was no literal infringement, no infringement under the Doctrine of Equivalents, and no reason to reach the issue of prosecution history estoppel.

Petitioner offers no persuasive reason to reverse several decades of decisions pertaining to the Doctrine of Equivalents.

A. Petitioner Waived Any Challenge To The CAFC's Construction Of Claim 1.

Following the trial in this matter, the District Court found that Claim 1 required a "sensing module" which included both the "receiving circuit" and "sensing means" or antenna. Petitioner did not appeal this construction of Claim 1 to the CAFC in its original appeal filed on November 23, 1999. Instead, the Petitioner argued the sensing means or antenna and the receiving circuit in the accused devices **could** all be, but were not required to be, located adjacent to the door and, therefore, the accused devices did infringe Claim 1.

Accordingly, Petitioner waived the right to challenge the construction of Claim 1. *TRW Inc. v. Andrews*, 534 U.S. 19, 34, 122 S.Ct. 441, 451, 151 L.Ed.2d 339, 352 (2001) (issue not reached because it was not raised or briefed below); *Department of Revenue of Montana v. Kurth*

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abeyance by this Court during the pendency of *Festo VIII* and summarily vacated and remanded in light of that decision.

Ranch, 511 U.S. 767, 772 n.9, 114 S.Ct. 1937, 1942 n.9, 128 L.Ed.2d 767 (1994) (argument was not raised below, so this Court declined to address it); *Demarest v. Manspeaker*, 498 U.S. 184, 189, 111 S.Ct. 599, 603, 112 L.Ed.2d 608 (1991) (since the question was not raised in the courts below, this Court declined to consider it for the first time); *Kosak v. U.S.*, 465 U.S. 848, 850 n.3, 104 S.Ct. 1519, 1522 n.3, 79 L.Ed.2d 860 (1984) (because petitioner did not present argument to the Court of Appeals, this Court declined to consider it); *Adickes v. S.H. Kress & Co.*, 398 U.S. 144, 147 n.2, 90 S.Ct. 1598, 1602 n.2, 26 L.Ed.2d 142, 148 n.2 (1970) ("Where issues are neither raised before nor considered by the Court of Appeals, this Court will not ordinarily consider them," even though they were presented to the district court, and raised by the petition for certiorari).

Further, Petitioner cannot now advance a construction of Claim 1 contrary to the construction to which it acquiesced in its original appeal. *See Sage Products, Inc. v. Devon Industries, Inc.*, 126 F.3d 1420, 1426 (Fed. Cir. 1997) (court refused to consider patentee's new theory of claim construction noting that with rare exception appellate courts do not consider a party's new theories lodged first on appeal). Accordingly, Petitioner's untimely challenges to the construction of Claim 1 provide no basis for granting Petitioner's writ.

B. This Court's Mandate Did Not Direct Or Require A Review Of The CAFC's Construction Of Claim 1.

This Court's mandate following the grant of Petitioner's First Petition for Certiorari remanded the case "for further consideration in light of *Festo Corporation v.*

Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd., 535 U.S. ___ (2002)." Nothing in that mandate directed the CAFC to address, let alone retract, its earlier construction of Claim 1. Therefore, the CAFC was well within its authority when it adhered to its original construction. *See Matz v. Household Intern. Tax Reduction Inv. Plan*, 265 F.3d 572, 576 (7th Cir. 2001) (on remand from Supreme Court, Court of Appeals would not reconsider holding not implicated in the Supreme Court's remand); *Laitram Corp. v. NEC Corp.*, 115 F.3d 947, 951 (Fed. Cir. 1997) (upon return of the mandate, the court may act on "matters left open by the mandate"); *Caldwell v. Puget Sound Elec. Apprenticeship and Training Trust*, 824 F.2d 765, 767 (9th Cir. 1987) (upon remand, district court cannot give relief beyond the scope of that mandate, but it may act on "matters left open by the mandate") (citing *In re Sanford Fork & Tool Co.*, 160 U.S. 247, 256, 16 S.Ct. 291, 293, 40 L.Ed. 414 (1895)); *Bankers Trust Co. v. Bethlehem Steel Corp.*, 761 F.2d 943, 950 (3rd Cir. 1985) (on remand court is free to make any order or direction in furtherance of progress of case, not inconsistent with the decision of the appellate court, as to any question not settled by the decision); *In re Potts,* 166 U.S. 263, 265-6, 17 S.Ct. 520, 521, 41 L.Ed. 994 (1897) (court may consider and decide any matters left open by the mandate of the court).

In this second Petition, Petitioner simply repeats the same claim construction arguments advanced in the first Petition. (R.App. 65-74). Specifically, Petitioner argues that the word "associated" in the claim language "the sensing module including a receiving circuit and associated sensing means located adjacent to the door opening to be monitored" permits the "sensing means" to be outside of the sensing module which contains the receiving circuit. However, that

construction conflicts with the clear meaning of the language "and associated sensing means located adjacent to the door opening to be monitored." (A-97). The claim language clearly states the sensing means is located adjacent the door. The specification explains that for the system to work the "sensing means" or antenna must be adjacent to the door. (A-86, 88, 90-91). Further, the use of the word "associated" after "receiver" and before "sensing means" clearly means both components are adjacent the door. The common and ordinary meaning of "associated" is "to join (things) together or connect (one thing) with another" and "to combine or join with another or others, as component parts." *Webster's Third New International Dictionary Unabridged* at 132 (1981). Based on the common and ordinary meaning of the claim language as corroborated by the specification, the construction by the district court and CAFC is correct.

Petitioner also argues Claim 4 supports a construction of the "sensing means" outside the housing. However, Claim 4 clearly refers to a different embodiment of the invention from the embodiment referred to in Claim 1. In the embodiment referred to in Claim 4, there are two door members and an elongated sensing member extending transversely across at least one of the door members. Under the doctrine of claim differentiation, the embodiment referred to in Claim 1 cannot have two door members and an elongated sensing member transversely across at least one of its door members. The specific language in Claim 1 refers to "a door" or "the door." (A-96-97). Furthermore, the sensing module in Claim 4 cannot be "located adjacent to the door opening" as required in Claim 1 and yet include "an elongated sensing member extending

transversely across at least one of the door members *in* the door opening" as claimed in Claim 4. (A-97).

Under the doctrine of claim differentiation:

> There is presumed to be a difference in meaning and scope when different words or phrases are used in separate claims. To the extent that the absence of such difference in meaning and scope would make a claim superfluous, the doctrine of claim differentiation states the presumption that the difference between claims is significant.

Comark Communications, Inc. v. Harris Corp., 156 F.3d 1182, 1187 (Fed. Cir. 1998) (quoting *Tandon Corp. v. U.S. Intern. Trade Com'n*, 831 F.2d 1017, 1023 (Fed. Cir. 1987)). Further, the doctrine normally means that limitations stated in dependent claims are not to be read into the independent claim from which they depend. *Karlin Technology, Inc. v. Surgical Dynamics, Inc.*, 177 F.3d 968, 971-2 (Fed. Cir. 1999); *Sunrace Roots Enter. Co., Ltd. v. SRAM Corp.*, 336 F.3d 1298, 1302-03 (Fed. Cir. 2003); *Wenger Mfg., Inc. v. Coating Machinery Systems, Inc.*, 239 F.3d 1225, 1233 (Fed. Cir. 2001).

Petitioner also argues the housing plays no role in the functions of the device. That is not the case. At Column 8, lines 8-13 of the '155 Patent, the passage relied on by the CAFC to assist in the construction of "sensing module," the patentee states: "[t]he switch 168 is connected by leads 170 and 172 to a housing 174 in which the receiver circuit 14 is located. The housing 174 has an output cable 176 which connects it to a remote nursing station where the alarm or buzzer is located and it also has a connection to a source of power." (A-95). If the housing referred to in these

lines of the patent were distinct from the physical sensing module, the system would not function.

Further, the sensing module housing *does* play a role in the reception of the radio signal *and* its application, because it is the sensing module housing to which the circuit 168 is connected by leads 170-172, which has the receiver circuit 14 within it, which has an output cable 176 which connects it to a remote nursing station where the alarm or buzzer is located, and which also has a connection to a source of power. This description by the patentee makes the sensing module housing a functioning part of the system.

Accordingly, the CAFC properly adhered to its original construction of Claim 1. This second Petition offers no persuasive reason for further review of the CAFC's claim construction.

C. The CAFC's Construction Of Claim 1 Is Supported By The Claim Language, The Specification And The File History.

Petitioner asserts the CAFC improperly imported an element – namely, a "housing" – into Claim 1 in contravention of this Court's decision in *McCarty v. Lehigh Val. R. Co.*, 160 U.S. 110, 16 S.Ct. 240, 40 L.Ed. 358 (1895). Contrary to the Petitioner's assertion, the CAFC did not import an element from the specification, but rather relied on the

claim language itself, as further supported by the specification.[2]

Claim 1 recites the components of the security sensing system to include a sensing module for installing adjacent to a monitored door. (A-96). The sensing module responds to the signals from the transmitter and produces an output response which in turn energizes an alarm, when the monitored door is open. (A-97). The sensing module is defined as "including a receiving circuit and associated sensing means," all of which are adjacent to the monitored door. (A-97). Claim 1 specifies that the receiving circuit is inside the sensing module. (A-97).

In both *Senior Tech. III* (A-14 – A-37) and *Senior Tech. IV* (A-1 – A-11) the CAFC properly construed the language of Claim 1 to include a limitation requiring that the "receiving circuit" (including a "sensing means" and a "means to enable the receiving circuit") be contained within the housing of the sensing module. Indeed, the court directly quoted the language of Claim 1 in determining that "[t]his sensing module, according to the claim, 'includes a receiving circuit and associated sensing means' [and a] 'means to enable the receiving circuit *in the sensing module. . . .*'" Petition at A-23 (emphasis in original) (quotations omitted). The CAFC thus properly determined that, "[*b*]*ased on the language of the claim*, one must conclude that the receiving circuit must be contained

[2] Petitioner erroneously argues that a court may consult the specification only when a term in the claim is ambiguous. That is not correct. The claims are part of the specification and the claims are construed in light of the specification. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979 (Fed. Cir. 1995); *aff'd* 517 U.S. 370 (1996).

within the sensing module"). Petition at A-23 (emphasis added); *see also id.* at A-3-4.

Moreover, it is clear that the specification was not the origin of the limitation as construed by the CAFC, but rather the specification was properly cited by the CAFC as "consistent with" and thus supporting its construction of the claim language, in that "[a]lthough the specification refers to the physical sensing module as a 'housing,' it is clear that the receiving circuit is located within it. . . ." *Id.* at A-23. "[T]he specification reinforces [the view that the patent claimed a receiving circuit and associated sensing means located within a housing] by providing that the associated sensing means, comprised of two ferrite inductors, be 'connected to a jack 86 for an external sensor. . . .'" (A-27). This language implies that the associated sensing means must be 'internal' as opposed to an 'external sensor.'" In addition, the CAFC cited to the prosecution history as revealing that "in order to 'clarify ambiguities,' Claim 1 was amended such that 'the receiving circuit' would be specifically located 'in the sensing module.'" *Id.* at A-23.

Therefore, contrary to Petitioner's ungrounded assertion that the single housing limitation was read into the claims from the specifications, the CAFC concluded that "the claim language, specification, and prosecution history **all** indicate that the receiving circuit must be contained within the housing of the sensing module." *Id.* at A-23-24 (emphasis added). It is evident that the CAFC properly construed Claim 1 "to require a *single housing* within which lies a receiving circuit." *Id.* at A-25 (emphasis added). *See Comark Communications, Inc. v. Harris Corp.*, 156 F.3d 1182, 1186-7 (Fed. Cir. 1998) (citing 1 Donald S. Chisum, *Chisum on Patents*, § 3.02[1] and n.12 (rel. Dec.

1996)) ("The line between interpreting claim language in light of the specification and reading a limitation from the specification into the claim is a fine one.").

This construction, together with the CAFC's construction of Claim 4 as to the components to be included in the "receiving circuit," served as the basis underlying the CAFC's finding that the accused devices did not infringe Petitioner's patent, either literally or under the Doctrine of Equivalents. Thus, Petitioner's contention that the CAFC's decision improperly read a limitation from the specification into the claims of the patent is wholly without merit.[3] To the contrary, this is another case in which the patentee must bear the cost of less-than-careful prosecution of its patent. *See Sage*, 126 F.3d 1420, 1425 (Fed. Cir. 1997) ("Given a choice of imposing the higher costs of careful prosecution on the patentees, or imposing the costs of foreclosed business activity on the public at large, this court believes the costs are properly imposed on the group best positioned to determine whether or not a particular invention warrants investment at a higher level, that is, the patentees.").

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[3] Petitioner asserts that the CAFC acknowledged Claim 1 read on the accused devices absent the "imputed" limitations. The CAFC never found or acknowledged that Claim 1 read on the devices or that there was evidence of literal infringement. Nor did the CAFC import any limitation to avoid a finding of literal infringement.

Petitioner also argues the specification describes three different arrangements of housings and antennas. The cited parts of the specification in fact describe the device claimed in Claim 1 which does have an antenna in the housing with the receiving circuit and two embodiments for the device claimed in Claim 4, which is necessarily a different device.

D. The CAFC Did Not Create A New Limitation On The Doctrine Of Equivalents Or Sidestep *Festo VIII* In Its Decision.

Petitioner argues that the CAFC's decision creates "a new limitation on the Doctrine of Equivalents" in order to improperly "sidestep[] [*Festo VIII*]." Petition at 12. Petitioner frames the issue for review as whether application of the Doctrine of Equivalents should be precluded *because* a claim limitation was "construed rather than being introduced by the patentee [presumably during the prosecution history]." Petition at i, 25-26. Petitioner argues that the single housing limitation, as construed by CAFC, is an "irrelevant limitation," that alternative arrangements incorporating two or more housings were not disclaimed because the invention is capable of operation with any such alternative, and that CAFC was thus in error in failing to apply the Doctrine of Equivalents in order to find that such arrangements infringe Petitioner's patent. *See* Petition at 25-28.

As demonstrated below, the CAFC did not impose a new limitation on the Doctrine of Equivalents, but rather followed a well accepted analysis of the effect claim limitations have on the Doctrine of Equivalents.

1. The CAFC Did Not Erroneously Fail To Apply The Doctrine Of Equivalents.

Petitioner argues for equivalency on the grounds that "if there is one housing there cannot be two housings, nor three, nor no housings, but in the case being reviewed, the invention will operate just as well with any of those alternatives." Petition at 28. This argument runs afoul of the well established principle that "the Doctrine of Equivalents

must be applied to individual elements of the claim, not to the invention as a whole." *Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co.*, 520 U.S. 17, 117 S.Ct. 1040, 137 L.Ed.2d 146 (1997). Moreover, where a patentee has drafted its claims narrowly, the public may utilize those elements expressly excluded in the patent without incurring infringement liability under the Doctrine of Equivalents, regardless of whether the device as a whole operates just as well with the alternative arrangement.

As the CAFC correctly instructed in *Sage Products, Inc. v. Devon Industries, Inc.*, 126 F.3d 1420, 1424-1425 (Fed. Cir. 1997):

> for a patentee who has claimed an invention narrowly, there may not be infringement under the Doctrine of Equivalents in many cases, even though the patentee might have been able to claim more broadly . . . A skilled patent drafter would foresee the limiting potential of the [narrower] limitation . . . [and] could have sought claims with fewer structural encumbrances . . . Instead, [patentee] left the PTO with manifestly limited claims that it now seeks to expand through the Doctrine of Equivalents. However, as between the patentee who had a clear opportunity to negotiate broader claims but did not do so, and the public at large, it is the patentee who must bear the cost of its failure to seek protection for this foreseeable alteration of its claimed structure . . . The public record reflects a manifest intention to claim this structure and no more. Whether actual or constructive, that intention now binds [the patentee].

Here, as in *Sage*, Petitioner has claimed a particular structure – the single housing limitation – and no more.

Even assuming *arguendo* that the invention operates just as well regardless of whether the receiving circuit is located in one or multiple housings, Petitioner cannot now expand its manifestly limited claims through the Doctrine of Equivalents when to do so would effectively eliminate an express limitation that the public has a right to rely upon.

The CAFC held that Petitioner could not rely upon the Doctrine of Equivalents in asserting that Respondent's devices infringed Claim 1 of its patent on the ground that "the patentee's choice of claim terms has plainly, necessarily, and implicitly excluded from the scope of the patent the embodiment it now seeks to capture through the Doctrine of Equivalents." (A-8). Petitioner argues this holding represents a new limitation of the Doctrine of Equivalents. (Writ at 12, 25-28). Such argument is without merit.

The Doctrine of Equivalents "is not a license to ignore or erase . . . structural or functional limitations of the claim, limitations on which the public is entitled to rely in avoiding infringement." *Athletic Alternatives, Inc. v. Prince Manufacturing, Inc.*, 73 F.3d 1573, 1582 (Fed. Cir. 1996) (quoting *Perkin-Elmer Corp. v. Westinghouse Elec. Corp.*, 822 F.2d 1528, 1532 (Fed. Cir. 1987) (internal quotations omitted)). Nor can it be employed in a manner that wholly vitiates a claim's limitations. *SciMed Life Systems, Inc. v. Advanced Cardiovascular Systems, Inc.*, 242 F.3d 1337, 1346 (Fed. Cir 2001). Where a patent clearly excludes an asserted equivalent structure, either implicitly or explicitly, the patentee may not rely upon the Doctrine of Equivalents to subsequently bring that structure within the scope of the patent. *Id.* at 1341 (When the specification "makes clear that the invention does not include a particular feature, that feature is deemed to be outside the reach of the claims of the patent, even though the language of the

claims, read without reference to the specification, might be considered broad enough to encompass the feature in question"); *accord Sage Products, Inc. v. Devon Industries, Inc.*, 126 F.3d 1420 (Fed. Cir. 1997); *Moore U.S.A., Inc. v. Standard Register Co.*, 229 F.3d 1091, 1106 (Fed. Cir. 2000) (holding that Federal Circuit's case law makes clear that all claim limitations are not entitled to an equal scope of equivalents, because the All Limitations Rule, prosecution history estoppel, or the narrowness of the claim language may operate to warrant little if any range of equivalents); *Athletic Alternatives*, 73 F.3d at 1582 (specific exclusions principle is "a corollary to the 'all limitations' rule").

Contrary to Petitioner's assertions, this principle is not a new limitation on the Doctrine of Equivalents. "As corollary to the 'all limitations' rule,[4] [the CAFC has] held that 'the concept of equivalency cannot embrace a structure that is specifically excluded from the scope of the claims.'" *Id.* (quoting *Dolly, Inc. v. Spalding & Evenflo Companies, Inc.*, 16 F.3d 394, 400 (Fed. Cir. 1994)); *Warner-Jenkinson Co., Inc. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 29-30 (1997) ("it is important to ensure that the application of the doctrine [of equivalents], even as to an individual element, is not allowed such broad play as to effectively eliminate [an] element in its entirety")). Thus, the well established principle of patent law applied by the CAFC in the decision below merely requires that the Doctrine of Equivalents not be applied to a clearly expressed structural limitation such

[4] Which requires, without exception, that an accused product contain each limitation or its equivalent. *See Athletic Alternatives*, 73 F.3d at 1582 (citing cases).

that the alleged equivalent would vitiate or eliminate that limitation.

In the instant case, the CAFC properly held that the single housing limitation of Claim 1, as construed by the court, was a clearly expressed structural limitation that would be effectively eliminated were a device that employs multiple housings held to be its equivalent. Petitioner's argument that the principle of law applied by the CAFC in this case is a new limitation on the Doctrine of Equivalents has no basis in fact or law.

2. The CAFC Did Not Improperly "Sidestep" *Festo VIII*.

Contrary to Petitioner's assertion, there is no indication that the Supreme Court "intended to require [the CAFC] on remand to limit [its] analysis to the theory [it] previously had followed." (A-6) (internal quotations omitted). Rather, in light of *Festo VIII*, the CAFC "further considered the case and concluded that the judgment of the district court should be affirmed on another ground." (A-6-7) (internal quotations omitted).

Also without merit is Petitioner's assertion that subsequent to *Festo VIII* "there is no longer a question of file wrapper estoppel by the amendments made to claim 1." Petition at 26. *Festo VIII* merely forbids the application of an absolute bar. Nothing in *Festo VIII*, nor in *Senior Tech III* and/or *Senior Tech IV*, prevents a reexamination of the prosecution history estoppel issue should such an inquiry be deemed necessary. In this case, the CAFC did not have to revisit the issue, because the case, on its present record, could be affirmed on other grounds. Using the existing record to affirm on alternative

grounds not only serves the interests of judicial economy, but further comports with the rule that an appellee is entitled to preserve its judgment on appeal based on any theory supported by the factual record. This is precisely the course taken by the CAFC in this case. *See* (A-22-23) (collecting cases).

Thus, there is nothing objectionable about the CAFC's focus on the language of the claims in its Doctrine of Equivalents analysis rather than upon the prosecution history. It merely represents an alternative ground for affirming the finding of non-infringement without remand to the district court.

E. None Of The Arguments Advanced By Petitioner Warrant The Overruling Of Past Decisions On The Doctrine Of Equivalents.

Petitioner argues that *Senior Tech IV* represents the latest in a line of CAFC decisions in which the CAFC improperly imported a limitation into a claim from the specifications to preclude a finding of literal infringement and to prevent an expansion under the Doctrine of Equivalents. Petitioner argues at least six cases (including *Senior Tech IV*) should be reversed and overruled to permit the application of Petitioner's conception of *Graver Tank* as the controlling authority for the Doctrine of Equivalents.

Overruling these decisions would effectively destroy a fundamental principle of claim construction – interpreting claims in light of the specification, of which they are a part. *See Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979 (Fed. Cir. 1995), *aff'd*, 517 U.S. 370 (1996). Further, reversal of these decisions would require reversal

of other decisions cited in these six cases or standing for the same proposition. *See, e.g., Cultor Corp. v. A.E. Staley Mfg. Co.*, 224 F.3d 1328 (Fed. Cir. 2000) (relying on explicit reference in the specification to construe claim); *Toro Co. v. White Consol. Industries, Inc.*, 199 F.3d 1295 (Fed. Cir. 1999) (relying on descriptions of structure of invention to construe the claim); *Tronzo v. Biomet, Inc.*, 156 F.3d 1154, 1159 (Fed. Cir. 1998) (specification touting advantages of structure of invention used in claim construction); *Netword LLC v. Centraal Corp.*, 242 F.3d 1347, 1352 (Fed. Cir. 2001) ("Although the specification need not present every embodiment or permutation of the invention, . . . neither do the claims enlarge what is patented beyond what the inventor has described as the invention.").

Petitioner offers no compelling reason for such a drastic action. At bottom, Petitioner is dissatisfied with a claim construction it never properly challenged on appeal, and disputes the CAFC's proper legal analysis under the Doctrine of Equivalents. Petitioner's response is to ask this court to change the analysis. This request should be summarily rejected, for it is the patentee's draftsmanship in this case, rather than a flaw in the CAFC's case law and analysis, that mandates the CAFC's claim construction and finding of no infringement. As between the patentee and the public, it is the patentee that should bear the consequences and costs of a poorly articulated or narrowly worded patent.

Petitioner further claims this case, as well as the other five Federal Circuit decisions Petitioner wants overruled, all serve to undermine the notice function of patents by permitting limitations on the scope of a claim without an antecedent finding of ambiguity in the claim language. In other words, Petitioner advocates a rule of

claim construction that would forbid any reference to the specification (and, by extension, the prosecution history), absent a prior finding that the claim language is ambiguous. However, Petitioner's argument evinces a fundamental misunderstanding of the relationship between the specification, the claim language (which is part of the specification), and the prosecution history. Contrary to Petitioner's assertion, these components of a patent are indispensable and inseparable from each other in the context of claim construction:

> [The patentee] misperceives the role of claim construction in the infringement analysis. The role is neither to limit nor to broaden the claims, but to define, as a matter of law, the invention that has been patented. The claims are always construed in light of the specification, of which they are a part. The role of the specification includes presenting a description of the technologic subject matter of the invention, while the role of claims is to point out with particularity the subject matter that is patented. ***The claims are directed to the invention that is described in the specification; they do not have meaning removed from the context from which they arose.*** Thus the claims are construed to state the legal scope of each patented invention, on examination of the language of the claims, the description in the specification, and the prosecution history.

See Netword LLC v. Centraal Corp., 242 F.3d 1347, 1352 (Fed. Cir. 2001) (internal punctuation and citations omitted; emphasis supplied).

Petitioner proposes to create an artificial and unwarranted separation of one component of the specification – the

claim language – from the remainder of the specification. The manifest purpose of Petitioner's proposed analysis is to expand the scope of claim language by considering it in a vacuum, completely divorced from even the most unequivocal limitation on the invention articulated in the balance of the specification.

Petitioner's attempt to seal off claim language from the rest of the specification is utterly at odds with well-settled principles of claim construction articulated in *Markman, Netword* and numerous other CAFC decisions. Moreover, separating claim language from the specification would create a perverse incentive on the part of patent applicants to secure patents by tempering overbroad claim language with unambiguous limitations in the rest of the specification, secure in the knowledge that a court would be barred from subsequently considering and enforcing those limitations absent a finding that the claim language is ambiguous in the first instance.[5] Thus, far from undermining the notice function, consideration of claim language in light of the specification actually enhances notice to the public by ensuring that patentees cannot expand claim language to implicate devices that are unambiguously forfeited when the specification and claim are read together.

A related theme emerging from the Petition is that claim language is analogous to the final version of a

[5] With respect to ambiguity, it is worth noting the CAFC found no ambiguity in the Petitioner's patent claims and specification. To the contrary, the CAFC implicitly found both the claim and specification unambiguous by holding that *both* supported its claim construction and finding of no infringement.

contract between the Patent & Trademark Office and the patentee. Thus, in Petitioner's view, the specification, prosecution history and other touchstones of claim construction would be the equivalent of "parol evidence," inadmissible without a prior finding of ambiguity.

Petitioner's contract law analogy is flawed for at least two reasons. First, a patent does not merely define rights and obligations running between the patentee and the Patent & Trademark Office. To the contrary, the overarching purpose of a patent is to circumscribe, for a period of time, the public's right to produce and innovate in the area covered by the patent. Thus, there is a strong public interest in holding claims to the scope articulated in the patent as a whole. Second, there is no corollary in patent law to the parol evidence rule governing the construction of contracts. To the contrary, it is well established that the claim language, the specification and the prosecution history each are necessary reference points for patent claim construction.

Finally, Petitioner misses the mark in its assertion that the CAFC's recent decisions, particularly as they relate to the Doctrine of Equivalents, have created uncertainty regarding the scope of patent rights. As this Court noted in *Festo VIII*, it is the very existence of the Doctrine of Equivalents that "renders the scope of patents less certain." *See Festo VIII*, 535 U.S. 722, 122 S.Ct. 1831, 152 L.Ed.2d 944, 955. So long as the Doctrine of Equivalents exists to expand a patentee's rights beyond the literal claim terms, there will invariably follow disputes over what is and is not an "equivalent." That said, the search for certainty does not warrant a departure from the Doctrine of Equivalents. *Id.* Likewise, the desire for greater certainty does not justify a departure from the rule

that the scope of an invention is defined by the combined meaning of the claim language, specification, and prosecution history. Indeed, Petitioner has made no showing that abandonment of this bedrock rule would result in any greater certainty in the law of patents.

In sum, the CAFC's decision is supported by well-established and sound principles of claim construction and this Court should reject Petitioner's proposed abandonment of those principles.

CONCLUSION

For all of the stated reasons, the Petition for Certiorari should be denied.

Respectfully submitted,

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APPENDIX

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Petition For Writ Of Certiorari (*Senior Technologies, Inc. v. R.F. Technologies, Inc.*, Case No. 01-0035) (Supreme Court July 2, 2001) ..... R.App. 56-86

R.App. 1

NONCONFIDENTIAL
00-1089, -1090

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

SENIOR TECHNOLOGIES, INC.,

Plaintiff-Appellant,

v.

R.F. TECHNOLOGIES, INC.,

Defendant-Cross Appellant.

Appeal from the United States District Court for the District of Nebraska in 97-CV-3241, Chief Judge Richard G. Kopf.

APPELLANT'S BRIEF

January 21, 2000

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Note: Pursuant to Fed. Cir. R. 28, certain materials subject to a protective order entered by the district court have been deleted from this brief. These materials concern certain circuit details of the defendant's accused Code Alert systems.

* * *

(6) STATEMENT OF THE ISSUES

The issues presented for review are:

a) Whether the district court's determination that the claim 1 and 6 receiving circuit in the '155 patent encompasses circuitry which is unconnected to a door switch and does not energize an alarm is harmful legal error;

b) Whether the district court's determination that the claim 1 and 6 receiving circuit in the '155 patent only encompasses the preferred embodiment receiving circuit of Fig. 4 is harmful legal error;

c) Whether the district court's use of a possible location of the Code Alert control unit instead of its intended and actual location to determine infringement is harmful legal error;

d) Whether the district court's own findings of fact concerning the accused Code Alert Systems demonstrate that the Code Alert microprocessor falls within the scope of the claim 1 and 6 receiving circuit in the '155 patent and that such claims are literally infringed as a matter of law when the claims are properly interpreted;

e) Whether dependent claims 2 and 8 of the '155 patent are infringed, when properly interpreted, by undisputed testimony concerning the Code Alert transmitters; and

f) Whether the district court's own findings of fact concerning the accused Code Alert Systems demonstrate that the Code Alert microprocessor is at least equivalent to the claim 1 and 6 receiving circuit in the '155 patent and that such claims are infringed under the doctrine of equivalents as a matter of law when the claims are properly interpreted.

(7) STATEMENT OF THE CASE

Senior Technologies, Inc. ("STI") is a Lincoln, Nebraska based manufacturer and distributor of a line of products commonly used by the nursing home and health care industries. A5. STI owns U.S. Patent Nos. 4,682,155 ("the '155 patent") and 5,268,670 ("the '670 patent"). A5, FF4[1]. STI brought a patent infringement suit against defendant RF Technologies, Inc. ("RFT") for infringement of the '155 patent and the '670 patent. A bench trial concerning infringement, 35 U.S.C. § 102(b) invalidity and

[1] FF = Finding of Fact by the district court, CL = Conclusion of Law.

inequitable conduct was conducted. A4. The district court issued findings of fact and conclusions of law on July 26, 1999. A30. Judgment holding the '155 and '670 patents noninfringed, valid and enforceable was entered on September 1, 1999. A1.

Four Models of Code Alert® wanderer protection systems were adjudged to be noninfringing by the district court in its September 1, 1999 judgment: the CA9000, the CA9100, the CA9120 and the CA600. A5. Additional models were dismissed from the suit at the close of plaintiff's case-in-chief; specifically, the CA series 100, 200, 200A, 200B, 500, 500A, 500B, 2000, 5000, 6000, 7100, 9200, 9300, and 9400. A5, n. 3. The latter models were dismissed because the district court determined, as trier of fact, that it was given insufficient testimony to aid its understanding of documentary evidence that plaintiff STI asserted described the manner in which these models operate. A1081. TT[2] 925:25-926:20. STI's appeal is limited to the district court's holding that the '155 patent is not infringed by Code Alert Wanderer Systems CA9000, CA9100, CA9120, and CA600.

(8) STATEMENT OF THE FACTS

STI manufactures and sells wanderer protection systems under trademark Wanderguard®. A5, FF2. Wanderers are persons who should not leave a facility due to various forms of dementia. A4, FF1. The patented and accused wanderer protection systems comprise small short range transmitters that are worn by a wanderer and a

[2] TT = trial transcript.

receiver located at an exit door or the like. A9, FF14; A78, Fig. 1; A10-11, FF18-21; A152, A157-159; A218-221; A241; A346. The patented and accused systems sound an alarm when a transmitter signal is detected (indicating a wanderer is present) and the door is opened. A9-11, FF14-16, FF18-21; A219. STI is the market leader in wanderer protection systems. A173. STI owns the '155 patent, which is directed to a wanderer protection system. A5-7, FF4-FF7.

John Shirley invented the invention disclosed and claimed in the '155 patent in March or April of 1985 when he first added a door switch to a previous system which had failed to meet his performance expectations. A14-15, FF34, 32-33. He applied for the '155 patent on January 13, 1986. A14, FF32. The '155 patent issued after a prosecution that included no rejections based upon prior art, and no amendments made to address prior art. A1237, TT 1544:4-8; A1516-27.

Prior to completion of the invention in March or April of 1985, Mr. Shirley entered into a business agreement with Mr. Louis Schrieber and Mr. Sid Martin to manufacture and market a wanderer monitoring system. A14-15, FF32. In 1984, they installed a system at the Evergreen nursing facility in Creve Coeur, Missouri, for field testing. A14-15, FF32. This system, known as a Model I, lacked a door switch and failed to perform satisfactorily. A15, FF34; A872-73, TT 92:5-95:17. A system was also installed in the Clayton on the Green nursing home in Missouri for testing. A15, FF33. No payment was received for this system, and Mr. Shirley and his business partners had free access to enter and leave Clayton on the Green to adjust and test the system. A15, 33.

Lack of success eventually led Mr. Shirley and his business partners to scrap the Model I design, and in the last week of 1984 or first week of 1985, Mr. Shirley commenced a two week design of what became a Model II. A874-75, TT 100:3-101:7. A small number of Model II's were constructed, all of which lacked door switches. A15, FF34; A874-75, TT 100:3-101:7. The major differences between the Model I and the Model II were that the Model II: (1) was of lower transmitting frequency (near 510 kHz); (2) included an audio modulation tone as intelligence to distinguish a transmitter signal from noise; (3) included transmitters having omnidirectional antennas, i.e., two antennas mounted at a 90 degree angle relative to one another; and (4) included a signal limiter. A875-76, 101:8-107:13. The Model II's performed better in testing, but produced an unacceptable number of false alarms. A877, TT 110:2-25. This led Mr. Shirley to add a door switch to the Model II in late March or early April of 1985. A15, FF34; A877, TT 110:16-111:25.

Before the door switch was added, the receiver of both Models I and II had a gain control which could be adjusted so that it would appear that an alarm would sound when the door was opened. A15, FF34. This was the case with the Model I installed at Clayton on the Green. A15, FF34. Even defendant's expert, Dr. Murphy, expressed his opinion that Mr. Shirley's early design efforts were toward designing a system to operate without a door switch. A15, FF34.

A. The Invention of the '155 Patent Uses a Door Switch to Enable an Alarm Response of the Receiving Circuit.

Claims 1 and 6 are the only independent claims of the '155 patent. A5, FF5. Claim 1 of the '155 patent includes a receiving circuit that responds to a transmitted signal from a transmitter installed on a person to energize an alarm when enabled by "means responsive to the opening of the door." A6, FF5; A84-85. The "means responsive to the opening of the door" is a door switch. A11, FF22. Claim 6 of the '155 patent has a receiving circuit with an output operatively connected to an alarm producing device and is also operatively connected to a door switch, i.e., "means to enable including switch means." A6-7, FF7, A85. More particularly, the systems claimed in the '155 patent include a small transmitter (10) worn on a wanderer's arm or leg (A78, see Fig. 1), which transmitter transmits a signal that is capable of being detected by a receiving circuit (A78-79, Figs. 3-4, see element 14) connected to and affected by the door switch (as described above), and an alarm. A9-10; A78-79, see element 68.

The receiver (14), also referred to as the sensing module in the written description, includes an antenna (54) ("sensing means" in the claims) mounted on or adjacent a monitored door. A9, FF14-15; A83, see column 5, lines 61-65; A78, see element 54. The door switch (168) is mounted to monitor the door and affects the receiving circuit when the door is open. A9-10; FF14, 16; A80, see Fig. 5. An alarm signal is generated by the system if and only if the transmitter signal is detected and the signal occurs indicating the door is open. A84-85, claims 1 and 6; A82, column 4, lines 39-52; A979-80, 11522:24-523:18; A9-10, FF15-16.

Fig. 4 of the '155 patent illustrates circuitry for the preferred embodiment of the invention. A9, FF15. Radio signals are received by two antennas 74, 76 mounted at 90 degree angles relative to one another to achieve omnidirectional sensing around a door. A889, TT 158:3-159:4. An AM superheterodyne radio 52 processes signals received by the antennas and outputs them through an audio transformer 90. A889, TT 159:11-16. The signal from the transformer 90 passes through a signal limiter (composed of diodes 94, 96) which protects the circuit from high voltages. A889-90, TT 159:19-161:10. The audio filter 106 passes those detected signals which are within the frequency range of the transmitter. A9, FF15. When a door switch 168 is closed to indicate a monitored door is closed, the transistor 112 is kept off. A10, FF16; A880-81; TT 164:1-165:16. The transistor 112 is also kept off if a transmitter signal is not received. A9, FF15; A881, TT 165:17-167:5. The transistor 112 turns on if and only if the door is opened, indicated by the opening of the door switch 168, and a transmitter signal is detected, indicated by an output of audio filter 106. A9-10, FF15-16; A168:24-170:9. When the transistor 112 turns on, the relay 124 closes the relay contact 128. A881, TT 166:3-167:9. The relay contact 128 supplies a voltage to turn on transistor 142 and sounds the alarm beeper BP-l 132. A881, TT 167:10-168:17.

B. The Accused RFT Devices Use a Door Switch to Determine Whether or Not a Received Transmitter Signal Should Cause an Alarm.

Defendant RFT manufactures and sells wanderer protection systems under the trademark Code Alert®. A5, FF3. RFT first manufactured and sold its CA9000

wanderer monitoring device in 1992. A9-10, FF18. The CA9100, CA9120, and CA600 are subsequent models that include additional features such as signal lights. A10, FF19-21. The Code Alert systems (CA9000, 9100, 9120, 600) include a transmitter, which continuously transmits a signal that is capable of being detected by a receive antenna. A9-10, FF18. The transmitter is worn by wanderers. A10-11, FF18-21; A152, A157-159; A218-221; A241; A346. A microprocessor determines whether a received signal was sent by a transmitter. A10, FF18. The Code Alert microprocessor also determines whether a door switch signal in the Code Alert systems indicates that a monitored door is open. A10, FF18. An alarm signal is generated by the Code Alert microprocessor if and only if the transmitter signal is detected and the signal indicating the door is open occur at the same time. A10-11, FF18; A219[3].

The Code Alert control unit (including the microprocessor), door switch, and antenna are intended to be mounted adjacent a door. A152, A157-159; A218-221; A241; A346[4].

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[5]

[3] A219, a page from a Code Alert CA9100 manual states: "When a magnetic reed switch is installed, Code Alert will not alarm unless both of the following conditions exist: 1. *A wanderer's transmitter is detected in the detection zone, 2. and the door is open.*" (Emphasis in original).

[4] "Confidential material has been deleted beginning here in nonconfidential sets of this brief pursuant to Fed. Cir. Rule 28(d)(1)(B).

[5] Confidential material has been deleted prior to here in nonconfidential sets of this brief pursuant to Fed. Cir. Rule 28(d)(1)(B).

C. The District Court's Finding that the '155 Patent is Not Infringed by the CA9000, CA9100, CA9120 and CA600 is Based Upon an Interpretation of "Receiving Circuit" as Excluding Microprocessors and Including Circuitry Which is Not Connected to a Door Switch or An Alarm.

The district court recognized that a primary issue of claim interpretation for the two independent claims of the '155 patent concerned the meaning of the claimed receiving circuit. A6, FF6. This is shown by the district court's fact findings that use Fig. 4, which includes the preferred embodiment receiving circuit 14, to identify the receiving circuit components of the preferred embodiment. A9-10, FF15-16. The district court concluded that the preferred embodiment receiving circuit in Fig. 4 "extends to the left of the point where resistor 136, diode 138, and the unnumbered relay contact directly above the connect." A9, FF15; A79. Among other things, this portion of Fig. 4 includes "AM radio [52] . . . , tone decoder [audio filter 106]", and the transistor 112. A9, FF15. Though left of the point identified by the district court in Fig. 4, the door switch 168 is not part of the receiving circuit, as recognized by the district court in identifying the "means to enable" as separate from the receiving circuit. (A9, FF14, "a means to enable the receiving circuit"; A10, FF16 "[t]he door switch electrically disconnects the left-hand part of the receiving circuit from the right-hand part of the receiving circuit"). A signal delivered from the transistor 112 produces "a response to energize the alarm." A9, FF15. "The transistor 112 can receive no signal when the door is closed." A10, FF16. Thus, the door being closed prevents the transistor from producing the "response to energize the alarm."

The function of the "tone decoder" (two-stage audio filter 106), according to the district court is "to look[s] for a single sinusoid 900 Hz wave." A9, FF15. This 900 Hz signal is produced by a wanderer's transmitter. A82, Col. 4, lines 60-65. Unmentioned by the district court is the fact that the specification of the '155 patent also explicitly contemplates the ability to identify specific wanderers by use of more than one transmitter signal for recognition. Column 6, lines 21-26 of the '155 patent explicitly states "[t]he audio modulation of the radio frequency signal can also be used to identify each person having a transmitter so that not only will the alarm be indicated but the system will also be able to identify particular residents." A83. Thus, the function of the "tone decoder" is to detect "a single sinusoid" wanderer transmitter signal or signals "to identify particular residents."

Despite the district court's identification of the Fig. 4 receiving circuit as being connected to the door switch (A9-11, FF14, 16, 22) and its being responsible for producing "a response to energize the alarm" (A9, FF15), the district court interpreted the receiving circuit of claims 1 and 6 in a manner which failed to encompass the very Code Alert circuitry that energizes an alarm and is connected to the door switch. A10-11, FF18-22. The district court recognized in indisputable fact findings that the Code Alert microprocessor determines if "a valid transmitter signal is received and if a monitored door is opened", and, if a transmitter signal has been received and "[i]f the door is open, the microprocessor activates an alarm." A10, FF18. The district court also recognized that the Code Alert microprocessor is connected to a door switch. A11, FF22. Even though the microprocessor performs these functions, the district court concluded that the microprocessor was

not part of the receiving circuit. A10-11, FF18 and 22. In other words, the court concluded that it looked like a duck, acted like a duck, but was not a duck.

An important inconsistency exists in the interpretation of the "receiving circuit" between the district court's findings concerning Fig. 4 of the '155 patent as being connected to a door switch and an alarm and the district court's identification of the Code Alert components that precede the microprocessor as corresponding to the claimed receiving circuit even though those components are neither connected to the Code Alert door switch or Code Alert alarm:

> The CA9000 consists of a transmitter and receive antenna which are mounted adjacent to a door, a control unit which includes *a receiving circuit and a microprocessor that analyzes the signals, and a door switch.*

A10, FF18. "The door switch (the means responsive to the opening of the door) in RFT's Code Alert products *is connected to the microprocessor, not the receiving circuit.*" A11, FF22. This explicit determination that the "receiving circuit" in the RFT Code Alert products is not connected to the door switch demonstrates that the district court interpreted the claimed receiving circuit to encompass the Code Alert circuit components which are not connected to or responsive to a door switch. Similarly, the district court's recognition that the Code Alert microprocessor energizes the Code Alert alarm demonstrates that the district court also interpreted the claimed receiving circuit to encompass the Code Alert circuitry which is unconnected to the alarm, i.e, the "receiving circuit" or "receiver" (A10, FF18) that precedes the microprocessor.

(9) SUMMARY OF THE ARGUMENT

A fundamental question in the interpretation of claims 1 and 6 of the '155 patent is the question of the scope and meaning of the receiving circuit included in those claims. The receiving circuit is the object affected by the means to enable in both claims.

The district court erred in construing the receiving circuit as encompassing Code Alert circuitry preceding a microprocessor in the Code Alert systems, but not the microprocessor. The circuitry preceding the microprocessor does not perform the claimed receiving circuit functions of responding to a door switch and a transmitter signal to sound an alarm, which are the exact functions that the microprocessor does perform. The district court's own findings of fact concerning the accused Code Alert devices demonstrate that the Code Alert microprocessor is connected to the door switch, is connected to the alarm, does determine whether a received signal is a transmitter signal, and does sound an alarm only if a transmitter signal is received and the door switch indicates that the door is open. The district court's own determination of the principal functions of the Fig. 4 receiving circuit demonstrate that the receiving circuit exhibits all of these characteristics of the Code Alert microprocessor. More importantly, those characteristics are the characteristics which find basis in claims 1 and 6 of the '155 patent.

Another internal inconsistency in the decision below which caused the district court to misconstrue the claims are the district court's contrary conclusions that a "left hand" portion of the Fig. 4 receiving circuit is unaffected by the door switch but that the claimed receiving circuit should be construed to be prevented from receiving

transmitter signals when the door is closed. The "left hand" portion of the Fig. 4 receiving circuit includes an AM radio 52 which receives transmitter signals and an audio filter 106 which determines when a transmitter signal is received. Contrary to the conclusion that the receiving circuit is prevented from receiving signals when the door switch indicates a closed door, the correct findings that the "left hand" portion is always operable indicate a receiving circuit which always receives signals.

The district court's analysis of the receiving circuit was clouded by its focus on contrasts between the preferred Fig. 4 receiving circuit and the Code Alert microprocessor. A long section of "contrasts" having no basis in the claims forms a substantial part of the district court's findings and improperly limits the receiving circuit to an analog circuit, having an analog audio filter, a transistor having a single input and which is short circuited when a door is closed, and a host of other features having no basis in either of claims 1 and 6.

Another legally flawed conclusion of the district court is its determination that since the Code Alert control unit (including the microprocessor) "*may* be located at an arbitrary distance away from the door opening" (emphasis added) it does not infringe claims 1 and 6. The manuals for each of the accused products clearly demonstrate that the suggested and typical location for the control unit is adjacent the door. Infringement is properly dependent upon the actual and intended location of the control unit, not where it *may* be located.

When the receiving circuit is properly interpreted to include the Code Alert microprocessor that is connected identically to the claimed receiving circuit and performs

the exact alarm sounding function of the claimed receiving circuit, the district court's own fact findings concerning operation of the accused Code Alert systems demonstrate infringement. Additional undisputable evidence shows that the Code Alert systems include transmitters that have two elements mounted at a 90 degree relationship for omnidirectional coverage, permitting this court to enter a finding of infringement with respect to claims 1, 2, 6, and 8 after correcting the legally flawed interpretation of receiving circuit and the legally flawed reliance on where the Code Alert control unit *may* be located.

The district court's analysis of the doctrine of equivalents was also legally flawed since it was not based upon the language of claims 1 and 6. Instead, the district court relied upon a "disruption of signal path" in the Fig. 4 circuit when the door switch indicates a closed door. The district court also concluded, without citation to any evidence, that the Code Alert system having a microprocessor is inherently different from the claimed receiving circuit due to the inherently different nature of analog and digital signals. The "disruption of signal path" finds no basis in the claims. Nor do the claims specify an analog receiving circuit or analog signals of any kind.

If the district court were correct in determining that the claimed receiving circuit is ever disabled from receiving signals, the question of equivalence then properly turns on the difference between an "always enabled" receiving circuit and a circuit enabled when the door is opened in the context of the alarm producing function of the claimed receiving circuit. Its own findings concerning operation of the Code Alert systems demonstrate that the Code Alert microprocessor performs the selective alarm function of the claimed receiving circuit, by responding to

a door switch and a transmitter signal just like the claimed receiving circuit, to result in an alarm produced only when both a transmitter is present and a monitored door is open. Coupled with defendant's own technical witness' volunteered admission that there is really no difference between an always enabled receiver and one which is enabled by the door opening, this demonstrates equivalence.

(10) ARGUMENT

I. The Appropriate Standard of Review For The District Court's Interpretation of All Aspects and Functions of the Claimed Receiving Circuit and Its Location, and the "Means to Enable", is *De Novo.*

"[A]s a purely legal question, [the Federal Circuit reviews] claim construction de novo on appeal including any allegedly fact-based questions relating to claim construction." *Cybor Corp. v. FAS Techs., Inc.,* 138 F.3d 1448, 1456, 46 USPQ2d 1169, 1172-73 (Fed. Cir. 1998) (en banc).

II. The District Court Erred in Construing the Receiving Circuit in Claims 1 and 6 of the '155 Patent as Encompassing Circuitry Which, By Itself, Produces No Output Response to Energize an Alarm and is Not Connected to a Door Switch.

"[T]he language of the claim frames and ultimately resolves all issues of claim interpretation." *AbTox Inc. v. Exitron Corp.,* 122 F.3d 1019, 1023, 43 USPQ2d 1545, 1548 (Fed. Cir. 1997). In determining the meaning of claim language, additional sources of information, i.e., the

specification, prosecution history and relevant extrinsic evidence, "provide a context to illuminate the meaning of claim terms." *Abtox*, 122 F.3d at 1023, 43 USPQ2d at 1548. "Nonetheless, throughout the interpretation process, the focus remains on the meaning of claim language." *Abtox*, 122 F.3d at 1023, 43 USPQ2d at 1548.

In the present case, the district court committed legal error by interpreting the '155 patent claim 1 and 6 *receiving circuit* in a fashion which contradicts language explicitly recited in the claims themselves and the district court's own fact findings. The district court's claim construction found a component in the Code Alert systems which it refers to as a "receiver" to be within the scope of the claimed receiving circuit, even though the district court was fully aware that what it labeled a "receiver" is not connected to the Code Alert door switch and does not produce an output which energizes the Code Alert alarm. A10-11, FF18 and 22. In so doing, the district court departed from the explicit language of claim 1, which requires the door switch to enable the receiving circuit's output to alarm means:

> means to enable the receiving circuit in the sensing module, whereby the receiving circuit can respond to signals transmitted by the transmitter module to produce a response for energizing the alarm means A6, FF5; A85.

In so doing, the district court also departed from the explicit language of claim 6, which requires "an alarm producing device operatively connected to the output of the receiving circuit" and "switch means operatively connected to the receiving circuit." A8-9, FF7; A85.

The receiving circuit in both of claims 1 and 6 is the object affected by the door switch, i.e., the means to enable. A5-7, FF5 and 7; A84-85. In claim 1, it is the receiving circuit which produces the output to energize an alarm when enabled by the door switch and reception of a transmitter signal. A6, FF5; A85. In claim 6, it is the receiving circuit which is connected to the door switch and the alarm. A7, FF7; A85. In determining what constitutes a receiving circuit in an accused device, these two features of the claimed receiving circuit should help define its metes and bounds since "the language of the claim frames and ultimately resolves all issues of claim interpretation." *AbTox Inc.*, 122 F.3d at 1023, 43 USPQ2d at 1548.

The district court correctly recognized that the Code Alert microprocessor connects to the Code Alert door switch and produces an output to energize an alarm. A10-11, FF18 and 22. In finding of fact 18 of the district court's findings and conclusions, the district court made the following observation (citations omitted):

> If the microprocessor determines that it has received an eight-bit coded signal at 65.5 kHz, it then checks to see if the door is open. If the door is open, the microprocessor activates an alarm.

The district court also observed that the "signal generated by the door switch" in the Code Alert systems "enters the microprocessor" (A12, FF24), that the "door switch (the means responsive to the opening of the door) in RFT's Code Alert products is connected to the microprocessor" (A11, FF22), and that the function of the Code Alert microprocessor includes "the function of sounding an alarm" (A12, FF26).

The microprocessor's function of sounding an alarm in response to a signal received by a door switch make the microprocessor's function the same as that of the claimed receiving circuit, which is responsive to *means to enable* (a door switch) and energizes *alarm means* (claim 1) or has its output connected to an *alarm producing device* (claim 6). A85. The district court, however, chose specific Code Alert circuitry which precedes the microprocessor as corresponding to the claimed receiving circuit even though this circuitry does not "sound an alarm" or respond to the Code Alert door switch. A10-12, FF18, 22, 25. The district court most often called the circuitry preceding the microprocessor "receiver", but in finding of fact 18, it is alternately labeled a receiver and a receiving circuit (citations omitted, emphasis added):

> The CA9000 consists of a transmitter and receive antennae which are mounted adjacent to a door, a control unit which includes *a receiving circuit and a microprocessor that analyzes the signals,* and a door switch. The transmitter operates at a frequency of 65.5 Khz and sends an eight-bit coded signal which is detected by a receive antenna mounted near the door. The signal is *sent to the receiver in the control unit where it is demodulated and then sent to the microprocessor.*

That finding of fact shows that the district court determined that circuitry preceding the microprocessor, sometimes called a "receiving circuit" by the district court but most often called a "receiver", falls within the scope of the claim 1 and 6 receiving circuit, while the microprocessor itself falls outside the scope of the claim 1 and 6 receiving circuit. This lead to the district court's explicit conclusion that the element preceding the Code Alert microprocessor,

i.e., the "receiver", is the element which corresponds to the claimed receiving circuit:

> The *door switch (the means responsive to the opening of the door)* in RFT's Code Alert products *is connected to the microprocessor, not the receiving circuit.* A11, FF22 (emphasis added).

Termed a conclusion of fact, the district court's conclusion includes the significant legal error of interpreting the claimed receiving circuit to encompass circuitry preceding the Code Alert microprocessor, which circuitry is not connected to the door switch and is not connected to the alarm. The explicit language of claims 1 and 6 of the '155 patent permits no such interpretation because the claims clearly define a receiving circuit as being connected to a door switch and an alarm. A85.

This is not a harmless error. "Improper claim construction can . . . distort the entire infringement analysis." *Moeller v. Ionetics, Inc,* 794 F.2d 653, 657 (Fed. Cir. 1986), 229 USPQ 992, 994, *overruled on other grounds, Cybor,* 138 F.3d at 1456, 46 USPQ2d at 1172-73. That is the effect of the district court's interpretation of receiving circuit as being a component which is neither connected to a door switch or an alarm. The receiving circuit in claims 1 and 6 is the explicit object affected by the means to enable and which produces the alarm output. In determining what constitutes a receiving circuit in an accused device, these two features of the claimed receiving circuit are critical to defining the metes and bounds of the invention. The district court lost sight of the claim language since it concluded that components preceding the microprocessor that embody neither of these features fall within the scope of the claimed receiving circuit.

Harm is also evident from the district court's identification of a component in the Code Alert systems which is connected in the exact fashion as the receiving circuit in the claims. This component is the Code Alert microprocessor, which as the district court observed in findings of fact 18 and 22, is connected to a door switch, recognizes transmitter signals and produces the output to sound the alarm. A10-11.

Placing the microprocessor within the definition of receiving circuit refutes each and every one of the district court's conclusions (A21-22, CL[6] 18-19) as to why the door switch in the Code Alert systems does not perform the same function as the claimed door switch (means to enable). When the district court concluded that the "door switch (the means responsive to the opening of the door) is not used in any of the four Code Alert devices at issue to enable the sensing module of the receiving circuit to respond to the signal transmitted by the transmitter module to provide an output response or to produce a response for energizing the alarm means" (A21, CL 18), the district court necessarily based its conclusion on its findings that the Code Alert "receiving circuit" is not connected to the door switch. (A11, FF22). The question begged by the district court's conclusion is how the claimed receiving circuit can encompass circuitry which is not connected to a door switch or an alarm. The district court's own findings of fact identify the Code Alert microprocessor as being connected to and responsive to the door switch. A10-11, FF18 and 22. Determining the microprocessor is

[6] CL = conclusion of law.

encompassed by the claimed receiving circuit alters the entirety of the district court's conclusions of law 18 and 19, which are premised entirely on the conclusion that the circuitry preceding the microprocessor is within the scope of the claimed receiving circuit (A10, FF18), while the microprocessor is outside of the scope of the claimed receiving circuit even though it connects in the exact fashion as the claimed receiving circuit to a door switch and an alarm.

* * *

VI. Claim 6 Does Not Require a Single Housing Containing a Separate "Sensing Module" and Receiving Circuit.

In conclusion of law 19, the district court distinguished the Code Alert systems from the claimed invention on the basis that in the accused Code Alert systems "the receiving circuit which responds to signals to produce a response is not *contained in the housing of the sensing module.*" A22. Claim 6 does require "a receiving device for mounting adjacent to the doorway including a housing and a receiving circuit therein." The claim makes no mention of "sensing module", however, and the district court concluded that "'[r]eceiver' and 'sensing module' are used interchangeably in the patent." A19, CL 12. The district court also identified the receiving circuit as element 14 in finding of fact 15, the very same reference numeral used interchangeably in the specification for the "receiver" and "sensing module." A9, FF15; A82, see, column 3, 1. 54. It is therefore improper to construe claim 6 as requiring a separate sensing module and receiving circuit that are contained in a single housing. The claim makes no use of "sensing module" and the terms "sensing module" and

"receiver" have the same meaning in the specification as demonstrated by the district court's own findings.

VII. The District Court Misapplied the Law of Infringement In Using a Possible Location of the Code Alert Control Module Instead of its Typical Location Adjacent a Door in the Infringement Analysis of the '155 Patent.

Apart from the issues concerning the meaning of receiving circuit, there is the straightforward issue as to whether the Code Alert control unit including the receiving circuit meets the claim requirement of adjacency to a door. A18, LF11. The district court committed the legal error of relying on potential locations of the Code Alert control unit that "may be . . . an arbitrary distance from the door opening" (A21, LF18) instead of its actual intended location. The Code Alert control unit[8] reed switch, and antenna are intended to be mounted adjacent a door as shown in manuals for each of the four accused models, as seen in the exemplary CA9100 arrangement in the figures on the opposite page taken from A218. The fact that the control unit "may be located at an arbitrary distance from the door opening" does not alter this conclusion. Manufacturing a device capable of an infringing use constitutes infringement whether or not the device may be capable of a noninfringing use. *Bell Communication Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d

[8] The control unit includes the microprocessor as testified by Dr. Murphy, defendant RFT's expert. A1199, TT1392:7-8 "It's [the CA9000 receiver] in the control module on the same printed circuit board as the controller [microprocessor]."

615, 622-23, 34 USPQ2d 1816, 1822 (Fed. Cir. 1995) ("an accused product that sometimes, but not always, embodies a claimed method nonetheless infringes"). Here, the defendant's own product manuals clearly show the control module adjacent the door. A152, A157-159; A218-221; A241; A346. That it "may" be located elsewhere is a legally insufficient basis to excuse infringement since infringement is a question of how the Code Alert devices are arranged, and not whether they "may" be arranged differently.

VIII. This Court Should Enter a Finding of Infringement of Claims 1, 2, 6 and 8 Because There is No Dispute Concerning Infringement if the Code Alert Microprocessor is Within the Scope of the Claim 1 and 6 Receiving Circuit.

This Court may proceed to determine infringement after correcting a flawed claim interpretation where there is no dispute as to the technical functioning of the accused device and application of the interpreted claims to the accused device does not create further disputes. *Wiener v. NEC Electronics Inc.*, 102 F.3d 534, 540, 41 USPQ2d 1023, 1028 (Fed. Cir. 1996) *citing, Mannesmann Demag Corp. v. Engineered Metal Prods. Co.*, 793 F.2d 1279, 1282, 230 USPQ 45, 46 (Fed. Cir. 1986) (determining infringement is a question of fact). Here, there is no dispute preventing this Court from entering a finding of infringement since the findings of fact establish infringement when the claims are properly construed. In addition, testimony of defendant's technical expert and technical fact witness establish operation demonstrating

infringement when "receiving circuit" is properly considered to encompass the Code Alert microprocessor.

Defendant's expert Dr Murphy insisted that the microprocessor was not part of defendant's receiving circuit, but it is clear that the claimed definition of receiving circuit was not being applied. On cross examination, Dr. Murphy became evasive and vacillated through alternate attempts to identify the receiver in the Code Alert products. A1199, TT 1390:5-1396:7 ("Q: Where does the receiver end in this [CA9000] circuit..? . . . A: That's a difficult question to answer because I'm not really sure how you're defining receiver", "I could state that it [the CA9000 receiver] is at one of several different positions and define it that way. It is not defined.").

The only thing Dr. Murphy was sure of was that the receiver ended before the Code Alert microprocessor. A1199, TT 1391:21-1392:14 ("Wherever the receiver is defined to end on this diagram prior to the control[ler]"). His testimony made clear that this was based on a "logical" definition having no apparent basis in the '155 patent or the eventual findings of the district court. A1200, TT 1396:1-7 ("I think I said that was another point where we could say the receiver ends, but fact is, we need a definition of a receiver in terms of this type of system before we can really say where it ends, and really, the most logical definition would be where the signal ceases to be analog in nature and becomes digital in nature"). This was contradicted, however, when Dr. Murphy compared the operation of the transistor 112 (part of the receiving circuit in finding of fact 15 (A9)) to operations of the Code Alert microprocessor. A1272, TT 2004:13-2005:24.

When Dr. Murphy was forced to consider the microprocessor part of the receiving circuit, Dr. Murphy admitted that the microprocessor is *precluded* from outputting a response to energize an alarm when the door switch indicates a closed door[9]. A1219-20, TT 1472:19-1476:24. The claim 1 receiving circuit is enabled to produce an output response to energize an alarm when the means to enable indicates an open door. A85. The output of the claim 6 receiving circuit is to the alarm producing device and the receiving circuit is connected to switch means which enable it when a door is opened. A85. These exact claim features are true of the Code Alert microprocessor that is *precluded* from producing an output to energize an alarm unless the door switch indicates an open door.

Thus, the question to resolve is whether the Code Alert microprocessor constitutes part of a receiving circuit as defined in claims 1 and 6. The analysis in the previous sections demonstrates that the receiving circuit is properly construed to include the Code Alert microprocessor, permitting this Court to enter a finding of infringement of claims 1 and 6.

The application of claims 2 and 8 is simple and based upon undisputed evidence concerning the Code Alert transmitters. Claim 2 of the '155 patent requires the claim 1 transmitter to include "a pair of inductors mounted in the housing at substantially right angles." A85. Claim 8 of

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[9] Demonstrating the superficiality of his opinion of noninfringement, Dr. Murphy, insisted that, although the Code Alert microprocessor is *precluded* from producing an output response when the door is closed, it is not *disabled* from producing an output response when the door is closed. A1220, TT 1475:22-1476:24.

the '155 patent specifies that the claim 6 "radiator in the transmitter device includes a pair of angularly related inductor elements." A85. Mr. Sharpf, a former engineer-employee of defendant, testified that the transmitters in the accused systems have two antennas mounted at right angles to each other. A1153, TT 1210:5-22. That testimony indisputably demonstrates that claims 2 and 8 are infringed if claims 1 and 6 are infringed.

IX. The District Court Failed to Use the '155 Patent Claim Language In Analyzing Infringement Under the Doctrine of Equivalents.

"The same interpretation must be employed in determining literal infringement and infringement under the doctrine of equivalents." *Senmed, Inc. v. Richard-Allan Medical Indus., Inc.,* 888 F.2d 815, 818, 12 USPQ2d 1508, 1511 (Fed. Cir. 1989). Accordingly, an improper interpretation of a claim element propagates into a legally flawed analysis under the doctrine of equivalents. *Litton Systems, Inc. v. Honeywell, Inc.,* 140 F.3d 1449, 1454, 46 USPQ2d 1321, 1324 (Fed. Cir. 1998) (vacating a jury finding of equivalence of a claim element where a district court misconstrued that claim element). The district court's equivalence analysis here is flawed due to its misinterpretation of the claimed receiving circuit.

Similarly to its failure to keep sight of the claim language in its literal infringement analysis, the district court's analysis under the doctrine of equivalents pays scant attention to the claim elements being considered. If this Court were to conclude that the Code Alert microprocessor did not fit the literal definition of the claimed receiving circuit, an appropriate analysis of the doctrine of equivalents demonstrates infringement.

A claim that does not literally read on an accused device may nevertheless be infringed under the doctrine of equivalents if the differences between the claim and the accused device are insubstantial. *See Hilton Davis Chem. Co. v. Warner-Jenkinson Co.*, 62 F.3d 1512, 1521-22, 35 USPQ2d 1641, 1648 (Fed. Cir. 1995) (en banc), *rev'd on other grounds, Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 41 USPQ2d 1865 (1997). This test was not applied correctly by the district court, since it repeatedly focused on functions and components having no basis in the claims.

A. There is No Claimed Basis for the "Disruption of Signal Path" that Controlled the District Court's Equivalents Analysis.

In a section very telling of the district court's failure to properly consider equivalents of the claimed elements, it relies upon the *General Electric v. Nintendo Co., Ltd.*, 179 F.3d 1350, 50 USPQ2d 1910 (Fed. Cir. 1999), case as supporting its finding of nonequivalence of the claimed receiving circuit and the Code Alert microprocessor. The Court concluded that there is a "disruption of signal path" to the transistor 112 in Fig. 4 when the door is closed and that no such disruption exists in the Code Alert microprocessor. A22 and A29, CL20 and 29. The problem with this analysis is, of course, that no such disruption exists in the claims either, unlike the *General Electric* case which analyzed a *claim* having an explicit "disruption of signal path" limitation. *See, General Electric*, 179 F. 3d at 1353-54, 50 USPQ 2d at 1913.

B. The Scope of Equivalents Turns Upon the Claimed Enablement of the Receiving Circuit to Produce an Output Response if the District Court's Interpretation of Claims 1 and 6 Were Correct, and RFT's Own Technical Witness Established Equivalence on Direct Examination by Counsel for RFT.

Assuming that the Code Alert systems include an "always enabled" receiving circuit and that the claimed receiving circuit is only able to receive signals when the door is open, as done by the district court (A19-22, CL 13, 14, 20), leaves the question as to whether or not an always enabled receiving circuit in the Code Alert systems is insubstantially different from a receiving circuit which is enabled only when the door is opened. The district court's analysis of this point is in paragraph 28 of its conclusions of law. Notably, that entire paragraph lacks any citation to evidence. A24-25.

Looking to the evidence instead of the unsupported conclusions of the district court reveals a far different answer. This answer is provided by Mr. Sharpf, a former RFT engineer and witness for RFT at trial. When asked by RFT's counsel, Mr. Sharpf testified that he didn't "really see any advantages or disadvantages" in the receiver always being enabled, as opposed to being enabled only when the door opened. A1142, TT 1167:18-1168:1.

C. The District Court's Analysis of Equivalence Between the Code Alert Microprocessor and Claim 1 and 6 Receiving Circuit is Improperly Based Upon Unclaimed Features and a Circuit Part and Connection Count.

"The limitations and functions of the invention in the claims, not the elements or functions of the accused device, establish the reference point for the doctrine of equivalents. Infringement under the doctrine does not vanish merely because the accused device performs functions in addition to those performed by the claimed device." *Miles Laboratories Inc. v. Shandon, Inc.*, 997 F.2d 870, 877, 27 USPQ2d 1123, 1128 (Fed. Cir. 1993) (citations to *Insta-Foam Prods., Inc. v. Universal Foam Sys., Inc.*, 906 F.2d 698, 702, 15 USPQ2d 1295, 1297 (Fed. Cir. 1990). The district court had the exact opposite focus: "the microprocessor is used to perform elaborate signal processing not disclosed in the patent." A23, CL25.

If it is assumed that a receiving circuit is limited to the analog embodiment circuit of Fig. 4, as the district court did, then a separate question is whether the microprocessor and related circuitry is equivalent to the claimed receiving circuit. The district court treated the question of equivalence between the Code Alert microprocessor and claimed receiving circuit as a circuit component and connection count and based its nonequivalence on admittedly unclaimed features with the observation that "the microprocessor is used to perform elaborate signal processing not disclosed in the patent, and not as a receiving circuit." (A23, CL25). The district court also views digital circuits to be inherent nonequivalents of analog circuits: "digital signals provide an inherently different product

that results from not mere improvements, but from inherent changes in the type of signal that generates the alarm." A24-25, CL28.

This is misguided. "One-to-one correspondence of components is not required" to establish equivalence under the doctrine of equivalents. *Sun Studs, Inc. v. ATA Equip. Leasing Inc.*, 872 F.2d 978, 989, 10 USPQ2d 1338, 1347 (Fed. Cir. 1989), *overruled on other grounds, A. C. Aukerman Co. v. R.L. Chaides Constr. Co.*, 960 F.2d 1020, 1038-39, 22 USPQ2d 1321, 1333 (Fed. Cir. 1992). As noted in the seminal *Pennwalt Corp. v. Durand-Wayland, Inc.*, 833 F.2d 931, 935, 4 USPQ2d 1737, 1740 (Fed. Cir. 1987) (en banc), "if . . . the accused devices differ only in substituting a computer for hard-wired circuitry, [the patentee] might have a stronger position for arguing that the accused devices infringe the claims."

Nor are digital circuits and analog circuits inherently nonequivalent, as stated by the district court without reference to any evidence. This court recently relied upon testimony stating that "[it is a] fundamental and well understood tenet of the computing art [that] . . . [a]ny software process can be transformed into an equivalent hardware process, and any hardware process can be transformed into an equivalent software process" in overturning a summary judgment finding that a claimed mechanical switch for selecting a code could not be equivalent to an accused garage door operator using software to set a code. *Overhead Door Corp. and GMI Holdings, Inc. v. The Chamberlain Group, Inc.*, 194 F.3d 1261, 1269, 52 USPQ2d 1321, 1326 (Fed. Cir. 1999).

Structural and functional equivalence between the presently claimed receiving circuit and the Code Alert

microprocessor is therefore not properly an examination of how to make the microprocessor perform the exact function of the unclaimed elements of Fig. 4 or an examination of the sophistication of signal processing performed by the microprocessor but not by the patented invention, as attempted by the district court in conclusions of law 25-28. *See also, Odetics v. Storage Technology, Corp., 185* F.3d 1259, 1266-1268, 51 USPQ 2d 1225, 1229-31 (Fed. Cir. 1999) (rejecting a district court's use of individual component analysis to determine the scope of structural equivalents for a claim element being analyzed under § 112, ¶ 6: "The individual components, if any, of an overall structure that corresponds to the claimed function are not claim limitations. Rather, the claim limitation is the overall structure corresponding to the claimed function."). "The component-by-component analysis used by the district court finds no support in the law." *Id. See, Endress + Hauser Inc. v. Hawk Measurement Systems Pty. Ltd.*, 32 USPQ2d 1768, 1776 (S.D. Ind. 1994) (a district court found a microprocessor performing the function of claimed "level indicating means" was equivalent under § 112, ¶ 6 to the "hard-wired" structure disclosed in the patent in suit) *aff'd, Endress + Hauser Inc. v. Hawk Measurement Systems Pty. Ltd.,* 122 F.3d 1040, 1043, 43 USPQ2d 1849, 1852 (Fed. Cir. 1997).

Assuming that the claimed receiving circuit does not literally encompass the Code Alert microprocessor, the correct analysis is to compare the overall function, way, and result of the receiving circuit to that of the Code Alert microprocessor and preceding circuitry including the antenna. The function of the microprocessor is the exact function of the claimed receiving circuit, responding to the door switch and a transmitted signal to activate an alarm.

A10-11, FF18. The way in which the Code Alert microprocessor operates is also substantially the same as the claimed invention. Though the microprocessor itself is not "short circuited," there is a transistor that controls its alarm output which is always off unless the door is opened. A1270-71, TT 1996:20-1998:25; A1277-78, TT 2023:15-2029:23. As admitted by Dr. Murphy, the Code Alert microprocessor is *precluded* from producing an alarm signal unless the door is open. A1219-20, TT 1472:19-1476:24. The short circuit of the transistor 112 in Fig. 4 of the patent also prevents it from turning on unless the door is opened. A10, FF16. Although the transistor at the output of the Code Alert microprocessor may not be "short-circuited," no appreciable difference exists, because it will still be precluded from turning on unless the Code Alert reed switch detects an open door. The result is also identical to that claimed in that an alarm is only produced when both a transmitted signal is received and the door is open. A10, FF18; A219.

(11) CONCLUSION AND STATEMENT OF RELIEF SOUGHT

For all of the above reasons, Appellant Senior requests reversal of the district court's judgment that the Code Alert CA9000, CA9100, CA9120 and CA600 do not infringe the '155 patent. Appellant further requests entry of judgment that claims 1, 2, 6 and 8 of the '155 patent are literally infringed by the Code Alert CA9000, CA9100, CA9120 and CA600, or alternatively, infringed under the doctrine of equivalents. Appellant Senior finally requests a

remand to the district court for a determination of damages owed to Senior due to infringement.

January 21, 2000

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UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

SENIOR TECHNOLOGIES, INC.,

Plaintiff-Appellant,

v.

R.F. TECHNOLOGIES, INC.,

Defendant-Cross Appellant.

Appeal from the United States District Court for the District of Nebraska in 97-CV3241, Chief Judge Richard G. Kopf.

PLAINTIFF-APPELLANT'S PETITION FOR REHEARING

March 23, 2001

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SENIOR TECHNOLOGIES, INC.
V. R.F. TECHNOLOGIES, INC.
No. 00-1089,-1090

CERTIFICATE OF INTEREST

Counsel for the Plaintiff-Appellant, Senior Technologies, Inc., certifies the following:

1. **The full name of every part or amicus represented by me is:**

   Senior Technologies, Inc.

2. **The name of the real party in interest represented by me is:**

   Senior Technologies, Inc.

3. **All parent corporations and any publicly held companies that own 10 percent or more of the stock of the party represented by me are:**

   Senior Technologies, Inc. has no parent company and has issued no shares to the public.

4. **The names of all law firms and the partners or associates that appeared for the party or amicus now represented by me in the trial court or agency or are expected to appear in this court are:**

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Note: Page citations from the Joint Appendix (record) are indicated by "A" followed by the page number, and citations from the Opinion of the Court of Appeals for the Federal District (a copy of which is an addendum to this Petition) are indicated by "Decision" followed by the page and line numbers.

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* * *

SUMMARY

The Court, having found clear error in the district court's decision of noninfringement (Decision, page 8, lines 3-6), turned to alternative grounds supported by the record (Decision, page 8, last two lines) for affirming the United States District Court for the District of Nebraska. However, in considering the alternative grounds for noninfringement of claim 1, it appears that factual mistakes or mistakes in overlooking a fact occurred. They probably occurred because the alternative ground was not briefed or argued in the same manner as the original issues. One mistake relates to whether a limitation was added to claim 1 by amendment when the same limitation

was in the original unamended claim. Another mistake relates to the roll of the housing in the invention of claim 1. A rehearing is requested on the alternative grounds for sustaining the lower court because the presence of possible mistakes related to substantial questions of patentability materially changes the basis for the Court's decision and the relevant facts and law have not been briefed or argued by the parties.

PRIOR HISTORY

On March 12, 2001, this Court decided an appeal by Senior Technologies, Inc. from a decision of noninfringement after a bench trial and R.F. Technologies, Inc. cross-appealed the court's rulings on issues of claim definiteness, invalidity, inequitable conduct, and attorney's fees. This Court affirmed the decision of the United States District Court (a copy of the opinion is an addendum to this petition).

However, in affirming the United States District Court's holding on patent infringement, this Court held that there was clear error on the part of the United States District Court in its holding of noninfringement (Decision, page 8, lines 3-6). This Court then considered alternative grounds to those that were briefed (Decision, page 8, last two lines) and this petition for rehearing concerns only the alternate grounds for affirming the decision of the United States District Court.

NATURE OF MISTAKE OF FACT

In its decision on alternate grounds, this Court held the doctrine of equivalents could not expand the scope of

claim 1 because of file wrapper estoppel. It held there was file wrapper estoppel on the ground that claim 1 was amended such that "the receiving circuit" would be specifically located "in the sensing module." The record, on the other hand, clearly shows that this limitation was in the original claim 1 and the amendment that is being discussed was not to cure an ambiguity as to this limitation but to change other language in the claim that is not in issue. The language in issue was incidental and conformed to the original limitation. It was editorial in nature and not related to patentability. The claim was clearly as patentable without that editorial change as with it since all of the limitations relating to that element were already in original unamended claim 1 that ended up in the granted claim 1. This is clearly shown by original claim 1, as filed before any amendment (page A001362), which recites (*language in issue is underlined*):

> "A security sensing system for monitoring the passage of persons through a door or like opening comprising:
>
> a trigger module for installing on persons to be monitored, a sensing module for installing adjacent to a door opening to be monitored, and means responsive to the opening of the door to enable the sensing module to respond to the signal transmitted by the trigger module to produce an output response, and alarm means energizable in response to the production of the output response to produce an alarm condition,
>
> the trigger module including a housing having a transmitter circuit, a source of power for the transmitting circuit and transmitting antenna means installed therein,

the sensing module including a receiving circuit and associated sensing means located adjacent to the door opening to be monitored, and,

means to enable the receiving circuit in response to the opening of the door whereby the receiving circuit can respond to signals transmitted by the trigger module to produce a response for energizing the alarm means."

This Court correctly pointed out that claim 1 was amended and as stated by the applicant for patent on page 4 of the only filed amendment (page A001384), "to clarify ambiguities, and to create consistency between the language of the claims and the specification". The amendment to which the Court refers was the addition of the language "the sensing module" resulting in the last clause stating "enable the receiving circuit in the sensing module". Claim 1 showing the added portions with underlining and the deleted portions in brackets as filed in the only amendment is shown below (page A001382):

"Claim 1 (as once amended). A security sensing system for monitoring the passage of persons through a door or like opening comprising:

a [trigger] transmitter module for installing on persons to be monitored, a sensing module for installing adjacent to a door opening to be monitored, and means responsive to the opening of the door to enable the sensing module to respond to the signal transmitted by the [trigger] transmitter module to produce an output response, and alarm means energizable in response to the production of the output response to produce an alarm condition,

> the [trigger] transmitter module including a housing having a transmitter circuit, a source of power for the [transmitting] transmitter circuit and [transmitting] transmitter antenna means installed therein,
>
> the sensing module including a receiving circuit and associated sensing means located adjacent to the door opening to be monitored, and[,]
>
> said means responsive to the opening of the door including means to enable the receiving circuit in [response to the opening of the door] the sensing module whereby the receiving circuit can respond to signals transmitted by the [trigger] transmitter module to produce a response for energizing the alarm means."

Thus the original claim contained the limitation in issue in the fourth paragraph and the amendment to the fifth paragraph was made to change "response to the opening of the door" to correspond in language to the earlier phrase "means responsive to the opening of the door" in the second paragraph. For consistency, with the limitation of the "sensing module including a receiving circuit" in paragraph 4 the limitation was restated in paragraph 5 as "receiving circuit in the sensing module" for clarity. More importantly, the same limitation was already in the claim because the language "sensing module including a receiving circuit" is the same as "receiving circuit in the sensing module". This is consistent with the ordinary meaning of the word "module" as being a group of components and with the use of "module" in the specification. When referring to a group of components (i.e. sensing module), to say that a component (i.e. receiving circuit) is in the group of components (i.e. sensing module) or within that group of components is the same as saying that the group of

components (i.e. sensing module) includes the component (i.e. receiving circuit).

The Court cites *Festo Corporation v. Shoketsu Kinzoku Kogyo Kabushiki Co.,* 187 F.3d 1381, 1381-82, 51 USPQ2d 1959, 1959-60 (Fed. Cir. 1999) (*"Festo V"*), *a* current case decided by this Court, which held ""a substantial reason related to patentability" is not limited to overcoming prior art, but includes other reasons related to the statutory requirements for a patent." However, in view of the failure of the amendment to further limit claim 1, it is the position of the Plaintiff-Appellant that *Festo V* does not hold that file wrapper estoppel is created by an amendment that does not further narrow a claim. Under *Festo V,* file wrapper estoppel is not created by amendments only related to conforming one portion of a claim to another which is an insignificant editorial change, but only to a change related to patentability.

Festo V held that an amendment that narrows the scope of a claim for any reason related to the statutory requirements for a patent will give rise to prosecution history estoppel and so the question is whether stating the limitation again limits that scope of the claim. Clearly it does not. A rehearing, as to the alternative reason for affirming the decision of the court below, would undoubtedly clarify this point as well as other points mentioned in the alternative reason for affirming the court below. This would provide a fair opportunity for both parties to for the first time provide their interpretation of the record related to this alternative reason for affirming the court below as to noninfringement. The scope of the doctrine of equivalents is affected by such a decision and the doctrine of equivalents is important to obtaining certainty in the interpretation of claims – a matter of public importance.

A second related issue was raised by the Court related to the doctrine of equivalents. That issue is whether the sensing means recited as being associated with the receiving circuit must be inside the housing (not specifically recited in claim 1) with other units construed to be inside the unrecited housing and because it is construed as being inside the unrecited housing the claim cannot be expanded by the doctrine of equivalents to include a sensing means outside of the unrecited housing. This appears to be based at least in part on a mistake in reading the claims and a mistake of fact based on the unargued issue. The Court notes that claim 4 depends upon and narrows the recitation of a sensing means in claim 1 by reciting the sensing means extends across a door. The Court states that because this contradicts the unrecited condition that the sensing means is inside the unrecited housing it must be excluded. The Court reasons there cannot be both an external and internal antenna for the receiver because one would be superfluous (Decision, page 14, line 20). However, there is nothing in this record indicating that a radio receiver cannot have both internal and external antennas and the recitation of a broad term "sensing means" in a parent claim does not preclude narrowing that term in a dependent claim under 35 U.S.C. § 112 which states in paragraphs 3 and 4:

> "A claim may be written in independent or, if the nature of the case admits, in dependent or multiple dependent form.
>
> Subject to the following paragraph, a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to

> incorporate by reference all the limitations of the claim to which it refers."

Claim 4 supports a construction that the sensing means may be outside of any housing rather than supporting the construction that the sensing means and receiving circuit must be within the unrecited housing. Moreover, the ordinary and usual meaning of the words, "associated with" is not "part of" but is "connected with" as an outside television antenna can be connected by a long wire to an inside television set.

The Court cites *Athletic Alternatives, Inc. v. Prince Manufacturing, Inc.*, 73 F.3d 1573, 1581, 1582-83, 37 USPQ2d 1365, 1372, 1373-74 (Fed. Circ. 1996) (*"Athletic"*), as indicating that once the "receiver circuit and associated sensing means" are construed as being in the unrecited "housing", the doctrine of equivalents cannot expand the claim to include the associated sensing means as being outside of the unrecited housing. This stems from the construction of claim 1 as including a housing, probably because the drafter of the specification in describing the preferred embodiment described a housing.

However, this appears to be the product of a mistake in the role or lack of role played by the housing in this invention. In *Athletic,* the dispute was over the interpretation of a vital part of the invention recited in the claims, namely (strings of a tennis racket) "vary continuously between a maximum of d1=1/2 inch in the center, to zero for the last lateral strings near the tip and the heel of the frame". The Court in *Athletic* referred to documents and file wrapper comments indicating that three strings were required and referred to logic explaining that in order to vary between one string and another requires a string

between the two extremes. The opponent argued that there only had to be two strings. The Court construed this clause, not to add elements because the strings were already recited, but to resolve the logical dispute over the scope of invention by interpreting language at the heart of the invention.

In this case, the dispute resolves around what must be in a housing. The problem centers on the failure of the decision to say how the housing can be considered as being in claim 1 before showing, that if the housing was construed to be in claim 1 then other parts might be in the housing if only the housing were in claim 1. There is a missing step about an insignificant part, the housing, not involved in the claimed invention in a claim not limited by file wrapper estoppel. There is a good reason why the housing is not in claim 1. The housing does not play a role in detecting wanderers, performing any of the functions of the recited components such as transmitting, sensing or receiving. This record does not contain any evidence that the examiner thought claim 1 was limited by a housing or any evidence the examiner allowed claim 1 because of such a limitation or that the applicant intended such a limitation in claim 1. The word "housing" has no more connection to claim 1 than any other piece of hardware that is mentioned in the specification but not recited in claim 1. This case is clearly distinguishable *from Athletic* because this case lacks a rationale for including the word "housing" in claim 1. Claim 1 should not be construed to include a housing and then permit a conclusion that components recited in claim 1 must be construed as being in the housing and then claim 1 construed to include the housing because the components must be in a housing. There is

nothing in this record indicating that the circuit of claim 1 will not operate without a housing.

There is no mention of a housing at all in this claim but only the functional language referring to the active electrical components such as "sensing module". There is no file wrapper estoppel and a full range of equivalents should be permitted. Clearly the sensing module can perform its function of sensing independently of an inanimate housing which according to its usual and common meaning is nothing more than a cabinet used to carry the functional elements from place to place and to protect them from the elements. It does not perform and can not perform a function of sensing.

The word "module" also has a common and ordinary meaning. It means a group of functional units. This meaning is supported by the specification and record. For example, in the specification of the patent-in-suit, reference is made to "trigger modules" in column 1, lines 11-12 and 17-18 (page A000081), and in other places. Reference is made to "transmitter modules" in column l, lines 53-54 (page A000081), and in column 6, line 40 (page A000083), and in other places; to "transmitter and receiver modules" in column 2, lines 7-8 (page A000081), and in column 4, line 27 (page A000082); and to "transmitter module or unit" in column 3, lines 24-25 (page A000082). Reference is also made to "receiver unit or module" in column 1, line 15 (page A000081), and so on. The specification is full of uses of the word "module" indicating a functional group and not suggesting modules need a housing or have a housing or don't need a housing or don't have a housing.

For example, it can be noted that in column 3 (page A000082), the actual words "sensing module" used in line 54 are indicated by the numeral 14 which is shown in

Figure 3 as indicating a block diagram of the functional units and in Figure 4 indicating the circuitry. In Figure 4, there is no indication at all of a housing and it is a schematic circuit diagram showing only components. Clearly the specification does not support the reading of sensing module in the alternative ground for noninfringement as being or including a housing. Its meaning is much broader in terms of the ordinary and common use of the word module, and the manner in which the word "module" is utilized as a word in the specification of the patent. While modules of any kind can be inside of and include housings there is nothing in this record to indicate they must include or be in a housing by their nature. They are nothing more than components gathered together to perform a function as shown consistently by the language and as indicated by the common and ordinary usage.

CONSEQUENCES OF MISTAKE OF FACT

The Court in construing claim 1 without argument on its interpretation as an alternative ground for affirming the lower Court risks damage to the important interests of the parties and the interest of the public in knowing the rules of claim interpretation so the public can determine its rights. The Court should grant a rehearing which will be the first hearing of relevant arguments and will bring the fire of our great advocacy system of justice to this complicated matter.

A full rehearing on the evidence supporting the doctrine of equivalents relating to this point may yield an entirely different decision as to infringement. Indeed the Court appears to indicate that this is true when it held with respect to claim 6 (Decision, page 11, lines 4-9):

> "Finally, the prosecution history reveals that originally, claim 6 merely listed "a housing" and "a receiving circuit" as the first two of several elements comprising the "receiving device." Had the claim been left unamended, one could argue that the claim language contains no requirement for the receiving circuit to be located within a housing. The list, however, was specifically amended to combine the first two elements into one by changing the language to read "a housing and a receiving circuit therein."

Claim 1 has never recited a housing and was never limited by amendment. There is no file wrapper estoppel since no limitation was added to the claim for any reason related to patentability. Amendments to claims related to clarity, such as for example correcting spelling, that do not have an effect on patentability but only on ease of readability, are not referred to in *Festo* as the Plaintiff-Appellant understands *Festo*. That argument should be permitted on rehearing to create certainty in the record as to whether the court below should be affirmed or reversed as to infringement.

This reasoning seems to apply even more strongly to the CA9000 model since the Court held (Decision, page 12, line 17 through page 13, line 10):

> "Contrary to the district court's determination, the CA9000 model could arguably meet the single housing requirement since the microprocessor and the preceding circuitry can be found in the same housing (i.e., the control unit). However, in the CA9100, CA9120, and CA600, the circuitry preceding the microprocessor was removed and placed in the antenna unit mounted near the door, while the microprocessor remained

> the control unit. As discussed above, both the microprocessor and the preceding circuitry corresponds to the limitation of "receiving circuit" in the '155 patent. By splitting the microprocessor and the preceding circuitry between two housings (i.e., the control unit and the antenna unit), these Code Alert products ceased to literally embody the single housing limitation of claims 1 and 6.
>
> As far as infringement under the doctrine of equivalents is concerned, both claims 1 and 6 were amended to overcome a rejection under 35 U.S.C. § 112, ¶ 2 (1994). Claim 1 was amended such that the receiving circuit is "in the sensing module," whereas claim 6 was amended to involve "a housing and a receiving circuit therein." Therefore, infringement under the doctrine of equivalents with regard to the CA9100, CA9120, and CA600 models is precluded. See Festo Corp., 2000 U.S. App. LEXIS 29979, at *25."

Since the decision as to claim 1 hinges to a large extent on what appears to be a mistake of fact in an alternate method not fully argued in the briefing, the Plaintiff-Appellant believes that a rehearing is appropriate and the best manner of insuring that all issues, including the alternative argument, are fully considered in the decision.

CONCLUSION

This decision of the Court decides the important rights of the parties on points of law and facts there were not argued or briefed as it has a right to do under its right or duty to see if there is an alternative ground for affirming the court below. However, in considering the alternative grounds for noninfringement of claim 1, it appears that there is a factual mistake or a mistake in overlooking

a fact that probably occurred because the alternative ground was not briefed or argued in the same manner as the original issues. A rehearing is requested on the alternative grounds for sustaining the lower court because the significant rights of the parties are at stake and the present determination of whether the doctrine of equivalents should broaden claim 1 in the manner argued by the Plaintiff-Appellant or not is a significant matter of law that will aid the public in certainty in determining infringement and in determining how to claim their inventions so as to provide the protection to which the public is entitled.

March 23, 2001 /s/ Vincent L. Carney

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UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

SENIOR TECHNOLOGIES, INC., Plaintiff-Appellant,	)	
v.	)	No. 00-1089, -1090
R.F. TECHNOLOGIES, INC., Defendant-Cross Appellant.	)	

PROOF OF SERVICE

The undersigned counsel for Plaintiff-Appellant, Senior Technologies, Inc., certifies that it caused to be filed the foregoing Plaintiff-Appellant's Petition for Rehearing, by overnight courier, to:

Clerk
U.S. Court of Appeals for the Federal Circuit
717 Madison Place NW
Washington, D.C. 20439

and certifies that it served true and correct copies of the foregoing Plaintiff-Appellant's Petition for Rehearing, by overnight courier, to:

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on this 23rd day of March, 2001.

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R.App. 56

No. ___

In The
Supreme Court of the United States

SENIOR TECHNOLOGIES, INC.,

Petitioner,

v.

R.F. TECHNOLOGIES INC.,

Respondent.

On Petition For Writ Of Certiorari To The U.S. Court Of Appeals For The Federal Circuit

PETITION FOR WRIT OF CERTIORARI

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QUESTIONS PRESENTED FOR REVIEW

1. Under what circumstances is it proper for the Court to construe a claim to include a limitation not directly recited in the claim?

2. Does an amendment to a claim that only repeats a limitation for clarity create file wrapper estoppel that prevents the doctrine of equivalents from being applied to the limitation under *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 187 F.3d 1381, 51 USPQ2d 1959 (Fed. Cir. 1999) ?

3. May a limitation that was construed to be in a claim but is not necessary to understand any other term in the claim be expanded under the doctrine of equivalents?

PARTIES TO THE PROCEEDING

Petitioner: Senior Technologies, Inc.

Petitioner's Corporate Disclosure Statement:

> Senior Technologies, Inc. has no parent company and has issued no shares to the public.

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* * *

The Petitioner, Senior Technologies, Inc., respectfully prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Federal Circuit, entered in this proceeding on March 12, 2001.

OPINIONS BELOW

The opinion of the United States Court of Appeals for the Federal Circuit for which review is sought, *Senior Technologies, Inc. v. R.F. Technologies, Inc.*, is an unpublished decision (decided March 12, 2001) and appears in Appendix A, pages 1-25. The judgment order of the Court of Appeals issued as a mandate on April 12, 2001, and appears in Appendix B, pages 26-27.

The published decision of the United States District Court for the District of Nebraska, *Senior Technologies, Inc. v. R.F. Technologies, Inc.*, is reported at 58 F.Supp.2d

1076 (D. Neb. 1999) and appears in Appendix C, pages 28-66.

The Denial of the Petition for Rehearing in *Senior Technologies, Inc. v. R.F. Technologies, Inc.* (not reported) entered April 5, 2001, appears in Appendix D, pages 67-68.

JURISDICTION

This case is a patent infringement case decided and entered by the United States Court of Appeals for the Federal Circuit on March 12, 2001, attached hereto in Appendix A. A timely filed petition for rehearing by the appellant was denied April 5, 2001, which denial is attached hereto in Appendix D.

The jurisdiction of this Court is invoked under 28 U.S.C. 1254(1) (1970). The pertinent portions of 28 U.S.C. 1254 are:

> "§1254. Courts of appeals; certiorari; certified questions
>
> Cases in the courts of appeals may be reviewed by the Supreme Court by the following methods:
>
> (1) By writ of certiorari granted upon the petition of any party to any civil or criminal case, before or after rendition of judgment or decree;. . . ."

STATUTES INVOLVED

Title 35 U.S.C. §112 (July 19, 1952, ch. 950, §1, 66 Stat. 798; July 24, 1965, Pub. L. 89-83, §9, 79 Stat. 261; Nov. 14, 1975, Pub. L. 94-131, §7, 89 Stat.691):

§112 Specification

* * *

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention."

Title 35 U.S.C. §271 (July 19, 1952, ch. 950, §1, 66 Stat. 811; Sept. 24, 1984, Pub. L. 98-417, §202, 98 Stat. 1603; Nov. 8, 1984, Pub. L. 98-622, §101, 98 Stat. 3383; Aug. 23, 1988, Pub. L. 100-418, §9003, 102 Stat. 1563-64; Nov. 16, 1988, Pub. L. 100-670, §201, 102 Stat. 3988-3989; Nov. 19, 1988, Pub. L. 100-703, §201, 102 Stat. 4676; Oct. 28, 1992, Pub. L. 102-560, §2, 106 Stat. 4230; Dec. 8, 1994, Pub. L. 103-465, §533, 108 Stat. 4988):

"§ 271 Infringement of patent

(a) Except as otherwise provided in this title, whoever without authority makes, uses, offers to sell or sells any patented invention, within the United States or imports into the United States any patented invention during the term of the patent therefor, infringes the patent."

STATEMENT OF CASE

I. Summary

On July 26, 1999, The U.S. District Court of the District of Nebraska issued its findings of fact and conclusions of law and ordered that judgment be entered against the plaintiff, Senior Technologies, Inc., on plaintiff's infringement claims for the reason that the defendant, R.F. Technologies, Inc., has not infringed plaintiff's United States Patents 4,682,155 or 5,268,670 and that judgment

be entered against the defendant and in favor of the plaintiff on defendant's counterclaims for the reasons that United States Patent 4,682,155 is not invalid under 35 U.S.C. § 102 and that the defendant failed to show inequitable conduct before the United States Patent and Trademark Office sufficient to declare U.S. Patent No. 4,682,155 and U.S. Patent 5,268,670 unenforceable. *Senior Tech; Inc. v. R.F. Tech.*, *58* F.Supp. 2d 1076 (D. Neb. 1999), see Appendix C.

The U.S. Court of Appeals for the Federal Circuit affirmed the District Court's judgment, but in doing so found clear error in its non-infringement holding, but then considered alternative grounds present in the record for affirming the District Court's conclusion of non-infringement, stating:

> ". . . . When the functions of the microprocessor are properly understood, and the claim is read on those functions, the presence of the microprocessor in the accused device provides no ground for noninfringement of the claims.
>
> We must, however, also determine whether the district court's conclusion of noninfringement can be affirmed on alternative grounds present in the record before us. . . ."
>
> (Appendix A, page 10, beginning with line 2 of the first paragraph)

This petition is directed to the holdings by the U.S. Court of Appeals for the Federal Circuit: (1) that claim 1 should be construed to include a sensing-module housing, which is not literally recited in the claim (Appendix A, page 10, third and fourth paragraphs); (2) that the doctrine of equivalents cannot be applied under *Festo Corp. v.*

Shoketsu Kinzoku Kogyo Kabushiki Co., 187 F.3d 1381, 51 USPQ2d 1959 (Fed. Cir. 1999), because claim 1 was amended to cure ambiguities (Appendix A, page 13, fourth paragraph); and (3) that any effort to expand claim 1 would eviscerate the construed limitation under *Athletic Alternatives, Inc. v. Prince Manufacturing, Inc.*, 73 F.3d 1573, 37 USPQ2d 1365 (Fed. Circ. 1996) (Appendix A, page 16, second paragraph).

II. The Action and Jurisdiction

This action was brought by the petitioner herein in the United States District Court for the District of Nebraska in July of 1997, for infringement of U.S. Patents 4,682,155 and 5,268,670. The defendant, R.F. Technologies, Inc., respondent herein, counterclaimed for a declaration of invalidity, noninfringement and unenforceability. The court entered judgment against the plaintiff and in favor of the defendant on plaintiff's infringement claim for the reason the defendant did not infringe plaintiff's United States Patent 4,682,155 or plaintiff's United States Patent 5,268,670. On defendant's counterclaims against the plaintiff, judgment was entered against the defendant and in favor of the plaintiff for the reasons that United States Patent 4,682,155 was not invalid under 35 U.S.C. 102 and R.F. Technologies failed to show inequitable conduct before the United States Patent and Trademark Office sufficient to declare U.S. Patents 4,682,155 and 5,268,670 unenforceable. See *Senior Tech., Inc. v. R.F. Tech.*, 58 F.Supp. 2d 1076 (D. Neb. 1999) (Appendix C, pages 28-66).

Jurisdiction and venue of the Court of first instance was invoked under Sections 1338(a), 1400(b), and 2201 of

Title 28 U.S.C. and Sections 271, 281, 283, 284 and 285 of Title 35 U.S.C.

The subjects in controversy were departure alert systems for providing an alarm when unauthorized persons, such as Alzheimer patients, passed through the doorway such as for example of a nursing home wearing a wrist transmitter.

III. Trial, Judgment, Findings of Fact and Conclusions of Law

On July 26, 1999, the District Court below entered its findings of fact and conclusions of law and a judgment order was entered on September 1, 1999, for the defendant, R.F. Technologies, Inc., on infringement, and for the plaintiff, Senior Technologies, Inc., on the counterclaim for invalidity. A copy of the reported case is in Appendix C, pages 28-66.

IV. Appeal to the U.S. Court of Appeals for the Federal Circuit

A Notice of Appeal was filed by Senior Technologies, Inc. on September 30, 1999, from the decision of noninfringement. A Notice of Cross-Appeal was filed by R.F. Technologies, Inc. on October 12, 1999, from the rulings on claim definiteness, invalidity, inequitable conduct, and attorney's fees. The case on appeal was argued on October 6, 2000, before the United States Court of Appeals for the Federal Circuit. It was decided on March 12, 2001. A petition for rehearing was sent to the Court for filing on March 23, 2001. The petition for rehearing was denied on April 5, 2001.

V. Holding of U.S. Court of Appeals for the Federal Circuit

The Court of Appeals found clear error in the District Court's decision of noninfringement (Appendix A, page 9, lines 11-16), but applied alternative grounds supported by the record (Appendix A, page 10, second paragraph) for affirming the U.S. District Court for the District of Nebraska. In considering the alternative grounds for noninfringement of claim 1, the Court of Appeals construed: (1) claim 1 as being limited by a single sensing-module housing (a housing for the transmitter is recited in claim 1, but not a housing for the receiver or sensing module) having a receiving circuit in it (Appendix A, page 10, third paragraph, through page 13); (2) the sensing module as including the receiving circuit (Appendix A, page 10, third paragraph, through page 13); (3) that the sensing means must be in the single construed sensing-module housing (Appendix A, page 14); and (4) the doctrine of equivalents cannot be used to expand the claim under *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 187 F.3d 1381, 51 USPQ2d 1959 (Fed. Circ. 1999) and *Athletic Alternatives, Inc. v. Prince Manufacturing, Inc.*, 73 F.3d 1573, 37 USPQ2d 1365 (Fed. Cir. 1996). *Festo, supra* was applied on the ground that claim 1 was amended "such that the 'receiving circuit' would be specifically located 'in the sensing module'" (Appendix A, page 14), and *Athletic, supra* on the ground it would "eviscerate the construed limitation" (Appendix A, page 16).

VI. Claims Presented for Review

Claim 1 of U.S. Patent 4,682,155 (pages A000077-A000085 of the Joint Appendix before the Court of Appeals) is the only claim presented for review. Claim 1 is:

"1. A security sensing system for monitoring the passage of persons through a door or like opening comprising:

a transmitter module for installing on persons to be monitored, a sensing module for installing adjacent to a door opening to be monitored, and means responsive to the opening of the door to enable the sensing module to respond to the signal transmitted by the transmitter module to produce an output response, and alarm means energizable in response to the production of the output response to produce an alarm condition,

the transmitter module including a housing having a transmitter circuit, a source of power for the transmitter circuit and transmitter antenna means installed therein,

the sensing module including a receiving circuit and associated sensing means located adjacent to the door opening to be monitored, and

said means responsive to the opening of the door including means to enable the receiving circuit in the sensing module whereby the receiving circuit can respond to signals transmitted by the transmitter module to produce a response for energizing the alarm means."

REASONS FOR ALLOWANCE OF WRIT

I. Summary

Each of the three questions presented for review relate to an aspect of the decision in this case that will make it difficult to know with certainty the scope of claims and thus more difficult to know with certainty what the public is free to do and what will infringe upon the patent rights of another.

Initially, the second question presented for review relates to the same point of law as another case for which this Court has recently granted a petition for a writ of certiorari, *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 00-1543 (case before the U.S. Court of Appeals for the Federal Circuit reported in 187 F.3d 1381, 51 U.S.P.Q. 1959 (Fed. Cir. 1999)). This case provides an example of how the decision in *Festo, supra* is being applied. The Petitioner suggests that this petition be granted and either be heard with the *Festo* case which is now before this Court, or be delayed until this Court has decided the *Festo* case, so that this case can be remanded for interpretation in the light of the decision of this Court in *Festo, supra*, if this Court should overrule or modify the lower Court's decision in *Festo, supra.*

The first question presented for review relates to a conflict between the decision in this case between Senior Technologies, Inc. and R.F. Technologies, Inc. and in the previous cases of *McCarty v. Lehigh Valley R. Co.*, 160 U.S. 110, 16 S.Ct. 240, 40 L.Ed. 358 (1895) and *Renishaw PLC v. Marposs Societa' Per Azioni*, 158 F. 3d 1243, 48 USPQ2d 1117 (Fed. Cir. 1998), as to when a limitation can be construed to be in a claim if it is not already recited in the claim.

The second question presented for review relates to whether the amendment of a claim to refer back to a limitation recited in the original claim by repeating the limitation creates file wrapper estoppel. This question may involve the interpretation of the holding in *Festo, supra* that applies file wrapper estoppel to prevent the application of the doctrine of equivalents for any amendment related to patentability. This interpretation of *Festo, supra* conflicts with the decision in *Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co.*, 520 U.S. 17, 117 S. Ct. 1040, 137 L.Ed. 2d 146 (1997).

The third question presented for review, while involving the scope of application of the doctrine of equivalents, relates most directly to the applicability of the doctrine of equivalents to expand the scope of a limitation construed to be in a claim. It thus involves both the *Festo* decision and another decision, *Athletic Alternatives, Inc. v. Prince Manufacturing, Inc.*, 73 F.3d 1573, 37 USPQ2d 1365 (Fed. Cir. 1996). *Athletic, supra* construed a claim to contain a limitation and refused to apply the doctrine of equivalents because expanding the construed limitation would eviscerate the construed limitation.

II. First question presented for review – Under what circumstances is it proper for the Court to construe a claim to include a limitation not directly recited in the claim?

A. Federal Question – Scope of Claims and Ability of Public to Know What Is Protected and What It Is Entitled to Use

This case provides a new criteria for construing a claim to include a limitation not recited in the claim. This

criteria appears to conflict with the long established law in which a limitation should not be imported into a claim unless it is necessary to rely on the limitation to determine what is meant by a limitation already in the claim, *Renishaw PLC v. Marposs Societa' Per Azioni*, 158 F. 3d 1243, 48 USPQ2d 1117 (Fed. Cir. 1998), *McCarty v. Lehigh Valley R. Co.*, 160 U.S. 110, 16 S.Ct. 240, 40 L.Ed. 358 (1895). Because literal infringement occurs only if the accused device contains every limitation in the claim, *North American Vaccine, Inc. v. American Cyanamid Co.*, 7 F.3d 1571; 28 USPQ2d 1333 (Fed. Cir. 1993), *cert. denied*, uncertainty as to the circumstances under which a limitation can be construed to be in a claim creates a corresponding uncertainty as to what the public can do and what would infringe on a patentee's rights. It is not clear how this new criteria applied by the Court of Appeals differs from reading a limitation into the claim from the specification, which is improper, *Renishaw*, *supra*, nor is it clear which limitations in the specification can be construed to be in the claim to limit its scope.

The new criteria construes a limitation to be in a claim when that limitation is associated in the description of the preferred embodiment with other limitations in the claim. In this case, the new criteria construes claim 1 to include the recitation of a sensing module housing which is not literally recited in the claim, by referring to the specification and to another independent claim, claim 6, to determine that a sensing means and a receiving circuit are in the same sensing module housing and therefore, there must be a sensing module housing.

More specifically, the Court of Appeals finds that the receiving circuit 14 is within the sensing module 14 and the sensing means is also part of the sensing module, and

from that concludes the claim must be limited to a sensing-module housing 174. Although it does not appear to be significant, the Court of Appeals also states that the specification refers to the physical sensing module as being a sensing-module housing, but the specification does not refer to the physical sensing module as a sensing-module housing and clearly distinguishes the two. That statement may have been triggered by Figure 5 in which the sensing-module housing is indicated by the numeral 174 with a lead line entering the sensing-module housing and the sensing receiver or sensing module 14 is indicated by the lead line and arrow head spaced from the total unit including the sensing-module housing 174. The specific language used in this construction is:

> "Claim 1 describes a monitoring system that includes a 'sensing module for installing adjacent to a door opening to be monitored.' This sensing module, according to the claim, 'includ[es] a receiving circuit and associated sensing means.' Furthermore, claim 1 mentions a 'means to enable the receiving circuit in the sensing module. . . .' (emphasis added). Based on the language of the claim, one must conclude that the receiving circuit must be contained within the sensing module. This position is consistent with the text and figures in the written description. Although the specification refers to the physical sensing module as a 'housing,' it is clear that the receiving circuit is located within it:
>
> > The switch 168 is connected by leads 170 and 172 to a housing 174 in which the receiver circuit 14 is located. The housing 174 has an output cable 176 which connects it to a remote nursing station. . . .

> '155 patent, col. 8, lines 8-11. Furthermore, the prosecution history reveals that, in order 'to clarify ambiguities,' claim 1 was amended such that 'the receiving circuit' would be specifically located 'in the sensing module.' Hence, the claim language, specification, and prosecution history all indicate that the receiving circuit must be contained within the housing of the sensing module."
>
> (Appendix A, page 10, beginning with the last paragraph)

and:

> "A limitation not clearly addressed by the district court was the location of the "associated sensing means" in claim 1. As a matter of law, we conclude that the "associated sensing means" in claim 1 must be located within the same housing as the receiving circuit."
>
> (Appendix A, page 14, third paragraph)

The sensing-module housing for the receiver is referred to only in column 8 of the specification, lines 9 and 10, which describe the mechanical connection of the cables as quoted above. It is shown in Figures 6, 7, and 8, but is only indicated by its reference numeral 174 in Figure 5.

The sensing module or receiver circuit 14 is referred to throughout the specification most notably in: column 1, lines 15, and 55; column 2, lines 6, 8, 58 and 59; column 3, lines 7, 8, and 54; column 4, lines 27, and 36; column 5, lines 61 and 62; column 6, lines 44, 49, 54 and 59; column 7, line 50 and column 8, lines 16 (part of receiver or sensing module), 18, 24 and 36. The receiver is described as being in the sensing-module housing in the specification

and is shown in two of the drawings as being in the sensing-module housing. The sensing means (antenna) is described in one embodiment as being in the sensing-module housing and in another as being on the door (Appendix A, pages 14-16).

The sensing module is not recited as a means plus function clause in claim 1 and there appears to be no other reason for construing this claim to include a sensing-module housing for the receiver other than the description in the specification which must describe the best mode of protecting the invention under 35 U.S.C. 112. The statute does not forbid a description of more than one mode but only requires the description of the best mode. The Court of Appeals does not hold that it is essential to interpret the sensing module as being the sensing-module housing, and it is not necessary since the entire sensing module is shown and indicated by reference numeral 14 in Figure 4 of U.S. Patent 4,682,155 (see Appendix C, page 66).

Moreover, as stated by the Court of Appeals (Appendix A, page 15), the dependent claim 4 has language further limiting claim 1, although the Court of Appeals states it describes a different embodiment than claim 1. I cannot be directed to a different embodiment and still incorporate claim 1 by reference. Instead it is following 35 U.S.C. 112, which states in paragraphs 3 and 4:

> "A claim may be written in independent or, if the nature of the case admits, in dependent or multiple dependent form.
>
> Subject to the following paragraph, a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A

> claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers."

Claim 4 supports a construction that the sensing means may be outside of any sensing-module housing rather than supporting the construction that the sensing means and receiving circuit must be within the unrecited sensing-module housing. Moreover, the ordinary and usual meaning of the words, "associated with" is not "part of" but is "connected with" as an outside television antenna can be connected by a long wire to an inside television set.

This manner of construing claims will create uncertainty in deciding when a claim is infringed and when a claim is valid since it appears to enable claims to be construed as including many limitations referring to an element in the claims that is described in the specification as being associated with a claimed element. There is no guidance concerning what details of the preferred embodiment can be construed into the claim and which cannot.

B. Conflict With Other Decisions

This case appears to be in direct conflict with *Renishaw PLC v. Marposs Societa' Per Azioni*, 158 F. 3d 1243, 48 USPQ2d 1117 (Fed. Cir. 1998), cited by the U.S. Court of Appeals for the Federal Circuit, as well as with *McCarty v. Lehigh Valley R. Co.*, 160 U.S. 110, 16 S.Ct. 240, 40 L.Ed. 358 (1895). These cases indicate that a limitation should not be imported into a claim unless it is necessary to rely on the limitation to determine what is meant by the limitation expressed in the claim. The rational for this holding was provided in *McCarty*, *supra* as follows:

> "[W]e know of no principle of law which would authorize us to read into a claim an element which is not present, for the purpose of making out a case of novelty or infringement. The difficulty is that if we once begin to include elements not mentioned in the claim in order to limit such claim . . . , we should never know where to stop."
>
> *McCarty v. Lehigh Valley R. Co.*, 160 U.S. 110, 116.

There is no need to further define the term "sensing module" by adding a new limitation in the claim nor does the Court of Appeals base its opinion on such a need. There is no issue relating to validity that involves a sensing-module housing in the lower Court's findings of fact and conclusions of law (see conclusions of law 32-41 in Appendix C, pages 58-61) and the sensing module housing does not play a role in the reception of the radio signal nor its application. There is no indication in this record that either the applicant or the examiner thought claim 1 to be limited by the recitation of a sensing-module housing when claim 1 was allowed.

III. Second question presented for review – Does an amendment to a claim that only repeats a limitation for clarity create file wrapper estoppel that prevents the doctrine of equivalents from being applied to the limitation under *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 187 F.3d 1381, 51 USPQ2d 1959 (Fed. Cir. 1999)?

A. Federal Question – Scope of Claims and Ability of Public to Know What Is Protected and What It Is Entitled to Use

In its decision on alternative grounds, this Court of Appeals held the doctrine of equivalents could not expand the scope of claim 1 because of file wrapper estoppel. It held there was file wrapper estoppel on the ground that claim 1 was amended such that "the receiving circuit" would be specifically located "in the sensing module." The record, on the other hand, shows that this limitation was in the original claim 1 and the amendment that is being discussed was not to cure an ambiguity as to the scope of the claim, but to conform a second recitation of a limitation to the first recitation of the limitation. The Court of Appeals relies on *Festo, supra* in its opinion. Thus *Festo, supra* is extended to cause editorial changes made to a claim that do not expressly limit the scope of the claim in themselves to create file wrapper estoppel. This extension will limit the ability of applicants and examiners in the United States Patent and Trademark Office to agree on editorial changes. It also raises issues that will cause doubt as to the scope of claims, such as how trivial must an editorial change be before it will not create file wrapper estoppel.

Claim 1 was amended after being rejected under 35 U.S.C. 112, second paragraph, as being indefinite in an Office action dated October 31, 1986 (page A001378 of the Joint Appendix before the Court of Appeals). That paragraph recited a number of other rejections under 35 U.S.C. 112, second paragraph, of a generally editorial nature, such as being unclear or containing typographical errors, such as "in" should be "is", or "transmitter" should read "transmitting". The applicant responded by making several changes to claim 1 (page A001382 of the Joint Appendix before the Court of Appeals) the relevant changes being to amend claim 1 from reading:

"Claim 1.

* * *

. . . a sensing module for installing adjacent to a door opening to be monitored, and means responsive to the opening of the door to enable the sensing module to respond to the signal transmitted by the trigger module to produce an output response . . .

* * *

the sensing module including a receiving circuit and associated sensing means located adjacent to the door opening to be monitored, and,

means to enable the receiving circuit in response to the opening of the door whereby . . . "

to:

"Claim 1.

* * *

. . . a sensing module for installing adjacent to a door opening to be monitored, and means

responsive to the opening of the door to enable the sensing module to respond to the signal transmitted by the transmitter module to produce an output response . . .

* * *

the sensing module including a receiving circuit and associated sensing means located adjacent to the door opening to be monitored, and

said means responsive to the opening of the door including means to enable the receiving circuit in the sensing module whereby . . . "

The amended claim includes the same limitations as the claim before being amended except stated differently in two respects, namely: (1) both versions of claim 1 recite " . . . means responsive to the opening of the door to enable the sensing module to respond . . . " (starting on line 3 of each version of claim 1 quoted above), but later the second version recites:

"said means responsive to the opening of the door including means to enable the receiving circuit . . . "

whereas the unamended version only again recites:

"means to enable the receiving circuit in response to the opening of the door . . . "

and (2) both versions of claim 1 recite "the sensing module including a receiving circuit and associated sensing means . . . " but while the unamended version never repeats that the receiving circuit is in the sensing module, the amended version does repeat this statement at the end of the clause quoted above as follows:

> " . . . means to enable the receiving circuit in the sensing module . . . "

The differences between the amended and unamended versions do not relate to any new limitation but only to the manner in which the limitations are expressed. Moreover, the amendments do not implicate prior art or validity over prior art.

Thus the original claim contained the limitation in issue in the fourth paragraph and the amendment to the fifth paragraph was made to change "response to the opening of the door" to correspond to language in the earlier phrase "means responsive to the opening of the door" in the second paragraph. For consistency, with the limitation of the "sensing module including a receiving circuit" in paragraph 4, the limitation was restated in paragraph 5 as "receiving circuit in the sensing module" for clarity. More importantly, the same limitation was already in the claim because the language "sensing module including a receiving circuit" is the same as "receiving circuit in the sensing module".

This interpretation of "sensing module" is consistent with the ordinary meaning of the word "module" as being a group of components and with the use of "module" in the specification. When referring to a group of components (i.e. sensing module), to say that a component (i.e. receiving circuit) is in the group of components (i.e. sensing module) or within that group of components is the same as saying that the group of components (i.e. sensing module) includes the component (i.e. receiving circuit).

B. Conflict With Other Decisions

This case appears to conflict with *Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co.*, 520 U.S. 17, 117 S. Ct. 1040; 137 L.Ed. 2d 146 (1997) in which this Court endorsed a compromise between the notice function of claims and fair protection objectives of claims. That compromise was to limit the application of the doctrine of equivalents to the substitution of an element recited in a claim with an equivalent element but not to apply the doctrine of equivalents to the invention as a whole. 520 U.S. 17 at 29. The Court expressly rejected the position that the reason for an amendment is irrelevant to file wrapper estoppel limiting the doctrine of equivalents. 520 U.S. 17 at 30 and 31.

In this case, file wrapper estoppel is applied to prevent the doctrine of equivalents related to an amendment that conformed language in a later portion of a claim to language already in the originally filed claim at an earlier location. There is no explanation given for refusing to apply the doctrine of equivalents to this single element except to cite *Festo, supra*, although the construed limitation could have nothing to do with prior art.

IV. Third question presented for review – May a limitation that was construed to be in a claim but is not necessary to understand any other term in the claim be expanded under the doctrine of equivalents?

A. Federal Question-Scope of Claims and Ability of Public to Know What Is Protected and What It Is Entitled to Use

The Court of Appeals denied the application of the doctrine of equivalents on another ground in addition to

Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 187 F.3d 1381, 51 USPQ2d 1959 (Fed. Circ. 1999) but one which raises the same questions about limitations on the doctrine of equivalents as raised by *Festo, supra.*

In this ground, the Court of Appeals cites *Athletic Alternatives, Inc. v. Prince Manufacturing, Inc.*, 73 F.3d 1573, 1581, 1582-83, 37 USPQ2d 1365, 1372, 1373-74 (Fed. Circ. 1996), as indicating that once the "receiver circuit and associated sensing means" are construed as being in the unrecited "housing", the doctrine of equivalents cannot expand the claim to include the associated sensing means as being outside of the unrecited sensing-module housing. In this case, the construed limitation "housing" was not put in the claim because of prior art but appears to be in the claim because the specification mentions it and the drawings show it, presumably as part of the description of the preferred embodiment.

However, this appears to be the product of a mistake in the role or lack of role played by the sensing-module housing in this invention. In *Athletic, supra*, the dispute was over the interpretation of a vital part of the invention recited in the claims, namely (strings of a tennis racket) "vary continuously between a maximum of dl=1/2 inch in the center, to zero for the last lateral strings near the tip and the heel of the frame". This recitation was inserted to distinguish over a reference to Lewis in which the splay did not vary. 73 F.3d 1573 at 1575. The Court of Appeals found the language susceptible of two meanings, one in which only two strings were necessary, resulting in infringement and one in which at least three strings were necessary resulting in no infringement, depending on which of two possible meanings of the word, "between" was accepted. 73 F.3d 1573 at 1579.

The Court of Appeals in *Athletic, supra* referred to documents and file wrapper comments indicating that three strings were required and referred to logic explaining that in order to vary between one string and another requires a string between the two extremes. The opponent argued that there only had to be two strings. The Court of Appeals construed this clause, not to add elements because the strings were already recited, but to resolve the logical dispute over the scope of invention by interpreting language at the heart of the invention in a manner to distinguish over prior art.

Unlike *Athletic, supra,* in this case, the dispute resolves around what must be in a sensing-module housing and the only prior art question before the Court of Appeals relates to the existence of an "on sale" or "public use bar" under 35 U.S.C. 102. Section 102 of 35 U.S.C. bars protection if the invention was on sale or in public use more than one year before filing its application. This prior art did not hinge on the sensing-module housing at all. The problem centers on the failure of the decision to say why the sensing-module housing may be construed as being in claim 1, before showing that, if the sensing-module housing is construed to be in claim 1, then the receiver and sensing means must be in the sensing-module housing if only the sensing-module housing were in claim 1. There is a missing step about an insignificant part of a radio receiver, the sensing-module housing.

There is a good reason why the sensing-module housing was not recited in claim 1. The sensing-module housing does not play a role in detecting wanderers nor in, performing any of the functions of the recited components such as transmitting, sensing or receiving. Unlike *Athletic, supra* (see 73 F.3d 1573 at 1581), this record does not

contain any evidence that the examiner thought claim 1 was limited by a sensing-module housing or any evidence the examiner allowed claim 1 because of such a limitation or that the applicant intended such a limitation in claim 1. The word "housing" has no more connection to claim 1 than any other piece of hardware that is mentioned in the specification but not recited in claim 1, nor is there any confusion about the meaning of terms.

There is no mention of a sensing-module housing at all in this claim but only the functional language referring to the active electrical components such as "sensing module". There is no file wrapper estoppel relating to prior art and a full range of equivalents should be permitted. Clearly the sensing module can perform its function of sensing independently of an inanimate sensing-module housing which, according to its usual and common meaning, is nothing more than a cabinet used to carry the functional elements from place to place and to protect them from the elements. It does not perform and can not perform a function of sensing.

The word "module" also has a common and ordinary meaning. It means a group of functional units. This meaning is supported by the specification and record. For example, in the specification of the patent-in-suit, U.S. Patent 4,682,155, reference is made to "trigger modules" in column 1, lines 11-12 and 17-18 (page A000081 of the Joint Appendix before the Court of Appeals), and in other places. Reference is made to "transmitter modules" in column 1, lines 53-54 (page A000081 of the Joint Appendix before the Court of Appeals), and in column 6, line 40 (page A000083 of the Joint Appendix before the Court of Appeals), and in other places. Reference is made to "transmitter and receiver modules" in column 2, lines 7-8 (page A000081 of

the Joint Appendix before the Court of Appeals), and in column 4, line 27 (page A000082 of the Joint Appendix before the Court of Appeals); and to "transmitter module or unit" in column 3, lines 24-25 (page A000082 of the Joint Appendix before the Court of Appeals). Reference is made to "receiver unit or module" in column 1, line 15 (page A000081 of the Joint Appendix before the Court of Appeals), and so on. The specification is full of uses of the word "module" indicating a functional group and not suggesting that modules need a housing or have a housing or don't need a housing or don't have a housing.

For example, it can be noted that in column 3 (page A000082 of the Joint Appendix before the Court of Appeals), the actual words "sensing module" used in line 54 are indicated by the numeral 14 which is shown in Figure 3 as indicating a block diagram of the functional units and in Figure 4 indicating the circuitry. In Figure 4, there is no indication at all of a sensing-module housing and it is a schematic circuit diagram showing only components. Clearly the specification does not support the reading of the sensing module in the alternative ground for noninfringement as being or including a sensing-module housing. Its meaning is much broader in terms of the ordinary and common use of the word "module", and the manner in which the word "module" is utilized as a word in the specification of the patent. While modules of any kind can be inside of and include housings, there is nothing in this record to indicate they must include or be in a housing by their nature. They are nothing more than components gathered together to perform a function as shown consistently by the language and as indicated by the common and ordinary usage.

This reasoning seems to apply even more strongly to the CA9000 model since the Court of Appeals held (Appendix A, page 13, third paragraph, through page 14, first paragraph):

> "Contrary to the district court's determination, the CA9000 model could arguably meet the single housing requirement since the microprocessor and the preceding circuitry can be found in the same housing (i.e., the control unit). However, in the CA9100, CA9120, and CA600, the circuitry preceding the microprocessor was removed and placed in the antenna unit mounted near the door, while the microprocessor remained in the control unit. As discussed above, both the microprocessor and the preceding circuitry corresponds to the limitation of "receiving circuit" in the '155 patent. By splitting the microprocessor and the preceding circuitry between two housings (i.e., the control unit and the antenna unit), these Code Alert products ceased to literally embody the single housing limitation of claims 1 and 6.
>
> As far as infringement under the doctrine of equivalents is concerned, both claims 1 and 6 were amended to overcome a rejection under 35 U.S.C. § 112, ¶ 2 (1994). Claim 1 was amended such that the receiving circuit is "in the sensing module," whereas claim 6 was amended to involve "a housing and a receiving circuit therein." Therefore, infringement under the doctrine of equivalents with regard to the CA9100, CA9120, and CA600 models is precluded. *See Festo Corp.*, 2000 U.S. App. LEXIS 29979, at *25."

B. Conflict With Other Decisions

This case also appears to conflict with *Warner Jenkinson Co., Inc. v. Hilton Davis Chemical Co.*, 520 U.S. 17, 117 S. Ct. 1040; 137 L.Ed. 2d 146 (1997) in its reliance on *Athletic, supra* in a manner similar to the conflict when the Court of Appeals relied on the *Festo, supra* case. In *Warner-Jenkinson, supra*, this Court provided a compromise between the notice function of claims and the fair protection objective of claims. That compromise was to limit the application of the doctrine of equivalents to the substitution of an element recited in a claim with an equivalent element but not to apply the doctrine to the invention as a whole. 520 U.S. 17 at 29. The Court expressly rejected the position that the reason for an amendment is irrelevant to file wrapper estoppel limiting the doctrine of equivalents. 520 U.S. 17 at 30 and 31.

In this case, the fact that an element was construed as being in the claim is applied to prevent the doctrine of equivalents related to that limitation construed to be in the claim. The construction of the claim to include an element for reasons not related to prior art or any other substantial reason related to patentability creates the same conflict between fair interpretation of the claim and predictability that was resolved by this Court in *Warner-Jenkinson, supra.* It should be resolved in the same manner.

V. CONCLUSION

The first question presented for review is to resolve confusion under the decision of the Court of Appeals about when a limitation can be construed to be in a claim and the second and third questions presented for review are to

resolve confusion under the decision of the Court of Appeals over when file wrapper estoppel will bar the application of the doctrine of equivalents from broadening the scope of a claim.

Under the second and third questions, the decision before this Court creates uncertainty as to what amendments can be safely made during examination of a patent application. Can the applicant correct spelling mistakes or grammatical mistakes, or as specifically involved here, can the applicant conform the language in one part of a claim to another part of the claim without waiving the doctrine of equivalents? Each of the questions relates to a conflict with existing case law. The questions are significant because this case leaves doubt as to what limitations can be added to claims from the specification and thus what the public may or may not do without infringing upon a patentee's rights.

Respectfully submitted,

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